

*United States Court of Appeals
for the
District of Columbia Circuit*



**TRANSCRIPT OF
RECORD**

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BRIEF FOR APPELLANT AND JOINT APPENDIX

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

United States Court of Appeals
for the District of Columbia Circuit

No. 18,717

FILED AUG 24 1964

SETRAK K. BOYAJIAN,

Nathan J. Paulson
CLERK

Appellant,

v.

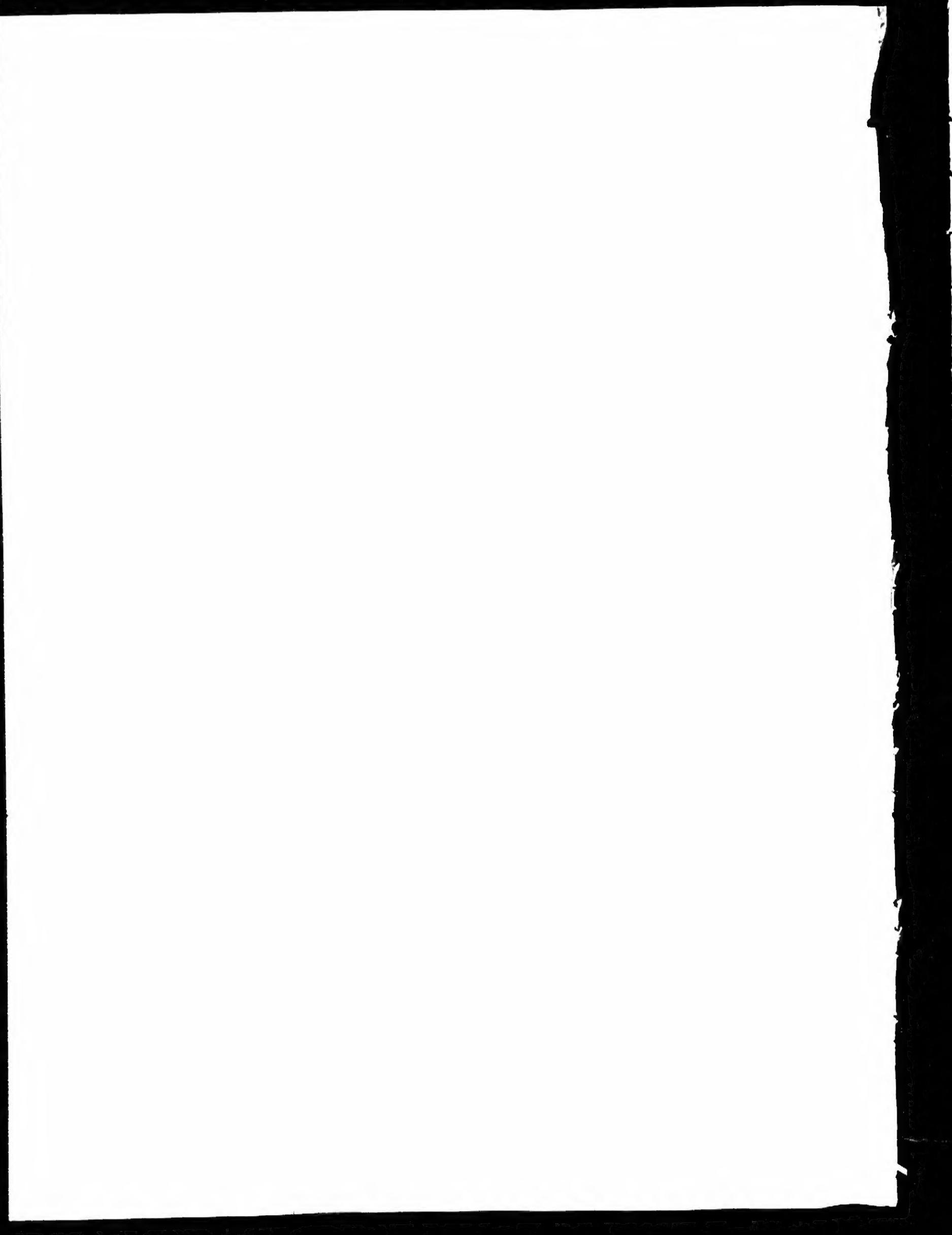
EDWIN L. REYNOLDS,
Acting Commissioner of Patents,

846
Appellee.

Appeal from the United States District Court
for the District of Columbia

SETRAK K. BOYAJIAN,
Appellant

P. O. Box 973,
Worcester, Massachusetts
01601



(i)

STATEMENT OF QUESTIONS PRESENTED

The question is:

1. Whether it is within the discretionary power of a public official wilfully and arbitrarily to refuse to obey a duty imposed upon him by statute?
2. Whether 35 U.S.C. 6 endows the Commissioner of Patents with such blanket powers as to escape his mandatory obligations at will by suspending the statutory provisions of Sections 122, 131, and 251 of U.S. Code 35, or to read elements of discretionary power into them?
3. Whether the word "shall" as used in said Sections 122, 131, and 251 places a mandatory obligation upon the Commissioner of Patents and is incompatible with the idea of "discretion", or it merely imports precatory suggestion?
4. Where a patent reissue application has run its full course of examination and has been found allowable by both the examining and law branches of the Patent Office, and thereafter all claims have been allowed and the application has been sent to the Issue Branch of the Patent Office, and the applicant has been served with a Notice of Allowance and the patent to be issued has received its issue date and number; whether the Commissioner of Patents has any power to withdraw said application from issue solely by yielding to pressure, influence, inducement, and/or representations from certain accused infringers, for the declared purpose of making certain rejections, without stating any new reasons or citing any new references?
5. Whether applicant had adequate remedy by appeal, where such course would have delayed the issue of his reissue patent for at least two years, where he had no assurance that after a second allowance upon such appeal his application would not again be arbitrarily withdrawn from issue as before, and where there is no specific provision in Patent Laws for such appeal from matters alleged in the complaint?

(ii)

6. Whether the Commissioner of Patents had discretionary power under any of the Patent Laws secretly to cooperate with certain accused infringers for the sole purpose of defeating and destroying applicant's patent?

(iii)

INDEX

TABLE OF CASES

	<u>Page</u>
* Setrak K. Boyajian, etc. v. Old Colony Envelope Co., et al., 279 F. 2d 572	4
Brown v. Hecht Co., 137 F. 2d 692	14
Cohen v. Young, 127 F. 2d 721, 726	14
* Commissariat A L-Energie Atomique v. Watson, 274 F. 2d 594	1
Delno v. Market St. Ry. Co., 124 F. 2d 960, 967	14
In re Koncus, 123 F. 2d 92, 95	14
McCarthy v. Boyden, 275 Mass. 91	15
* In re Moore v. United States ex Rel. Chott, 40 App. D.C. 591	9, 10, 11, 13
Pitman Construction Co. v. Housing Authority of Opelousas, 168 F. Supp. 517, 523	15
Reeves v. Pennsylvania R. Co., 9 F.R.D. 487, 489	14
Triangle Candy Co. v. United States, 144 F. 2d 195	15
United States v. Ganz, 48 F. Supp. 323, 327	14
* In re James Donald Walker, 327 F. 2d 977; 139 USPQ 480	9, 13

STATUTES

* U.S. Code, Title 5, Section 1009	1, 2, 7, 9, 10, 12, 16, 1(a), 2(a)
U.S. Code, Title 35, Section 6	(i), 14, 15, 2(a)
* U.S. Code, Title 35, Section 122	(i), 8, 14, 15, 3(a)
* U.S. Code, Title 35, Section 131	(i), 5, 14, 15, 3(a)
* U.S. Code, Title 35, Section 112	3(a)
U.S. Code, Title 35, Section 251	(i), 14, 3(a)

RULES

Rules of Practice of the United States Patent Office:

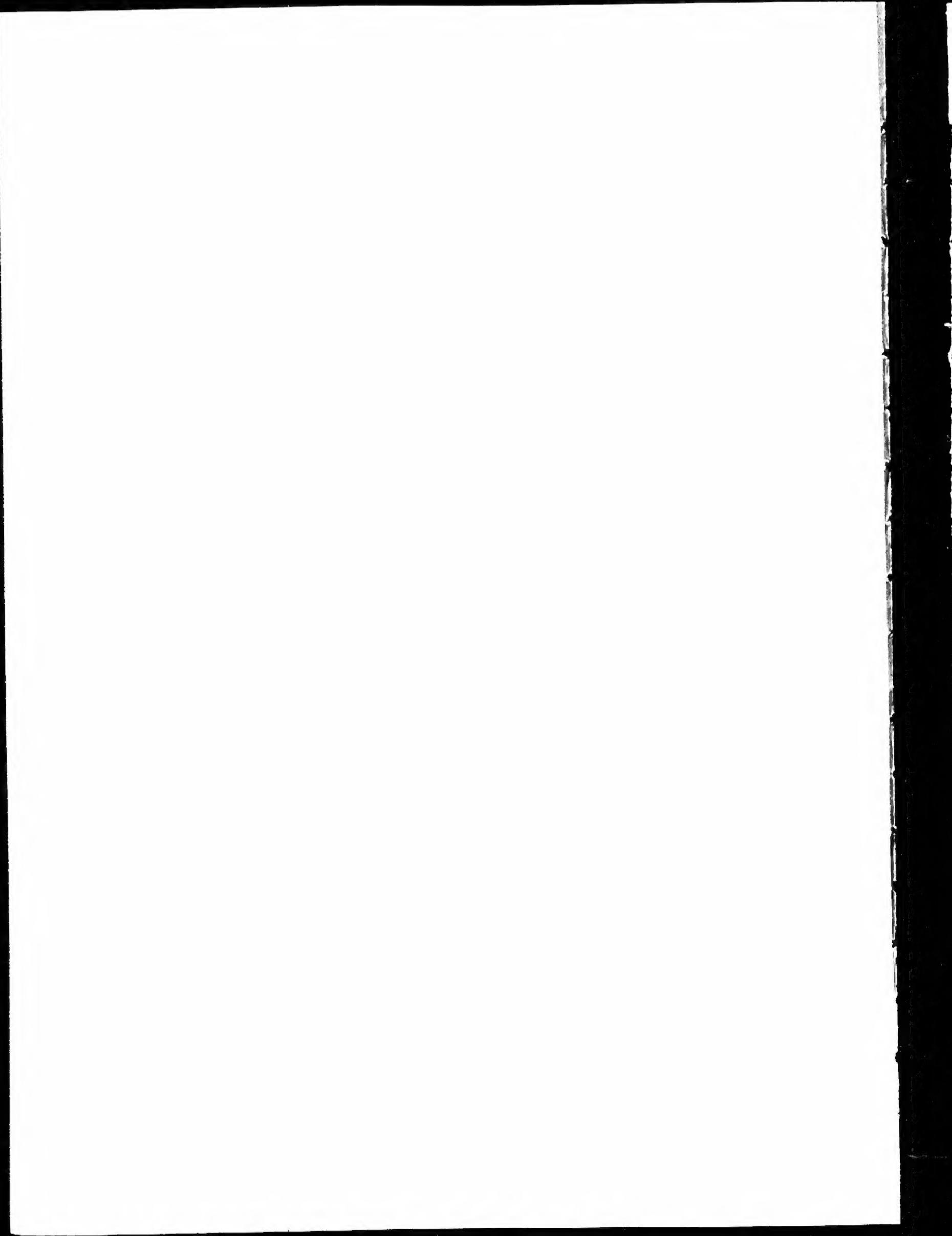
Introduction, Paragraph Z(b)	12
* Rule 14(a)	4(a)
Rule 291	4(a)
* Rule 311	4(a)
* Rule 312	5(a)
* Rule 313	8, 5(a)

(v)

	<u>Page</u>
F.R.C.P., Rule 73(a)	1
F.R.C.P., Rule 81(b)	1, 2

REGULATIONS

Manual of Patent Examining Procedure:



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,717

SETRAK K. BOYAJIAN,

Appellant,

v.

EDWIN L. REYNOLDS,
Acting Commissioner of Patents,

Appellee.

Appeal from the Judgment of the United States
District Court for the District of Columbia

BRIEF FOR APPELLANT

JURISDICTIONAL STATEMENT

Jurisdiction of the Court below over the parties and issues herein was founded upon 5 U.S.C. 1009, and 28 U.S.C. 1651(a). (See also *Commisariat A L-Energie Atomique v. Watson*, 274 F.2d 594). Also see Rule 81(b), *Federal Rules of Civil Procedure*.

Jurisdiction of this Court is invoked pursuant to the same statutes and decision, above cited; and Rule 73(a) of *Federal Rules of Civil Procedure*.

STATEMENT OF THE CASE

This is a civil action commenced in the Court below by appellant herein, on December 28, 1963, by filing therein a petition (hereinafter referred to as "complaint") for mandatory relief (J.A. 2-9). Mandamus as a District Court writ is abolished by Rule 81(b) of Federal Rules of Civil Procedure. The same rule, however, provides mandatory relief "by appropriate action or by appropriate motion." Review as of right is more specifically provided in Title 5, U.S. Code, Section 1009 (Appendix A) and proceedings herein are largely predicated upon such provision.

Defendant (the Acting Commissioner of Patents) in the Court below (appellee herein) did not make any answer to the merits of the complaint, but on February 19, 1964, filed a motion to dismiss (J.A. 19), alleging that "I. The Court lacks jurisdiction over the subject matter of the complaint;" and that "II. The complaint fails to state a claim against defendant upon which relief can be granted." The case came up for hearing on said motion to dismiss on March 13, 1964, and on March 16, 1964, the District Court entered an order (J.A. 22) dismissing the complaint. On May 15, 1964, plaintiff duly filed a notice of appeal (J.A. 22). The case is before this Court on that appeal. By order of this Court (July 24, 1964) time for filing appellant's brief (and the joint appendix of the parties) was extended to and including August 24, 1964. This brief (and the joint appendix) is served and filed within the time so extended.

A brief outline of material facts and allegations set forth in the complaint (J.A. 2-9) which for the purpose of the motion to dismiss in the Court below, as well as for the purpose of this appeal, are presumed to be admitted, show that, upon a lengthy and thorough examination, the reissue application involved was found by the Primary Examiner (as well as by others concerned in the Patent Office) to be allowable and so he allowed and sent it to the Issue Branch of the Patent Office (J.A. 15).

Thereafter applicant was served with a Notice of Allowance (J.A. 16) and a pink slip (J.A. 17) assigning an issue date and number for the Patent to be issued. But later applicant received an Office Letter (J.A. 17-18) from the Patent Office informing him that his application had been withdrawn from issue for the purpose of rejecting certain claims therein, and rejecting six of the 17 claims allowed, without stating any new reasons or citing any new references.

A somewhat more detailed consideration of the prosecution record of said reissue application reveals the following facts:

On August 27, 1957, the original patent (J.A. 11-14) was issued to appellant herein (on application filed on September 4, 1953).

On December 30, 1957, certain accused infringers filed an action for declaratory judgment against appellant herein in the District Court for the District of Massachusetts, alleging non-infringement and invalidity. Appellant herein counterclaimed.

On June 9, 1959, appellant herein filed the said application in the Patent Office for the reissue of his said patent (J.A. 11-14) on the ground that he had claimed less than he had the right to claim therein.

On July 16, 1959, said accused infringers petitioned the Commissioner of Patents for an access to the said reissue application, together with lengthy arguments against the granting thereof.

On August 19, 1959, the Commissioner of Patents granted the access to said accused infringers, despite the vigorous opposition of appellant herein.

On September 16, 1959, said District Court for the District of Massachusetts granted plaintiffs' motion for summary judgment in the said declaratory action by declaring all claims of the said original patent invalid. Appellant herein appealed to the U. S. Court of Appeals for the First Circuit.

On December 14, 1959, the Examiner rejected all claims of the reissue application, including all claims of the said original patent (J.A. 11-14).

On June 14, 1960, said U. S. Court of Appeals for the First Circuit reversed the decision of said District Court for the District of Massachusetts, and vacated its decree of invalidity. (*Setrak K. Boyajian, etc. v. Old Colony Envelope Co., Inc., et al.*, 279 F.2d 572)

On July 13, 1960, said accused infringers petitioned the Patent Office for further access to said reissue application. That petition also contained vehement argument against said reissue application.

On August 3, 1960, the Patent Office denied the access, stating that no "special circumstances" were found to exist to justify the access (Appendix C), and that access can be given only to the application as filed and not to the proceedings in the case. It also rejected all argument against the application.

On May 11, 1961, the Patent Office again rejected all claims in the said reissue application, including all claims from the said original patent (J.A. 11-14).

On September 1, 1961, attorney for said accused infringers made the following statement in said District Court for the District of Massachusetts:

"The Patent Office, they are not resisting access. Their position is, this being a contested litigation now, that they would prefer to have some indication of the Court's interest in this application as to its relevance.

"The matter has been *reviewed* (emphasis added) with Solicitor Schimmel, who handles these petitions for access, and he has said that it does not make any difference to him so long as there is some indication by the Court"

On April 2, 1962, the Examiner finally rejected all claims in said

reissue application, including all claims from the said original patent (J.A. 11-14).

On April 17, 1962, said accused infringers filed a third petition in the Patent Office for access to the prosecution history of said reissue application. That petition was granted.

On September 24, 1962, appellant herein petitioned the Commissioner of Patents (Ladd) personally to vacate the final rejections on the ground that the said reissue application had not been examined as required by 35 U.S.C. 131 (Appendix D) and that such final rejection was made prematurely.

On October 3, 1962, Commissioner Ladd granted the said petition to vacate the said final rejection, over his personal signature, by the following decision:

"Consideration has been given the petition filed September 24, 1962 under Rule 181, requesting essentially that the Commissioner personally review and vacate the examiner's final rejection of April 2, 1962.

"This application, filed June 9, 1959 is an application for the reissue of Patent No. 2,804,395, granted August 27, 1957, the application having been filed after a declaratory action seeking to invalidate the patent was filed in the United States District Court of Massachusetts. The District Court, on a motion for Summary judgment based upon certain patents and publications, held all the patent claims invalid, but the judgment was reversed by the First Circuit Court of Appeals in a decision dated June 14, 1960, on the ground that it was error to grant summary judgment invalidating the patent claims on the documentary record. Subsequently, the District Court in a memorandum dated September 7, 1962 denied a motion for stay of proceedings pending final disposition of all proceedings in the Patent Office, and set December 1, 1962 as the time for receipt of briefs supporting or opposing plaintiff's motion for summary judgment on the issue of infringement.

"The reissue application contains all the original patent claims, which stand rejected on the patent and

publication found inadequate by the Court of Appeals. It is this rejection that petitioner asserts is unreasonable, unjustified, and an attack upon the validity of the patent, which the Court has held, in effect, to be presumptively valid.

"Sufficient unusual circumstances exist in this case to justify the Commissioner's intervention by supervisory authority. In view of the Court's decision with respect to the identical references relied upon by the examiner, justice requires that full effect be given the Court's decision at this time. Accordingly the examiner is authorized and directed to withdraw the final rejection of April 2, 1962, and in view of applicant's response of October 2, 1962, to suspend action on this case, pending the Court's final decision as to the applicability of the cited references on the issue of patentability.

"The petition is granted to the extent indicated."

Sgd. DAVID L. LADD
Commissioner

On May 15, 1963, Commissioner Ladd's conditions of suspension of action on the said reissue application having been met, appellant herein was invited in an office interview to request for the resumption of its prosecution.

On July 16, 1963, appellant herein sent his request, in writing, together with certain amendments, to the Primary Examiner, that the prosecution of said reissue application may be resumed, and it was so resumed, resulting in the allowance of the application as recited in the complaint and exhibits (J.A. 2-18).

During the resumed prosecution of said reissue application, and long before it was allowed, appellant herein submitted to the Primary Examiner, as exhibits in the case, the entire record of the court proceedings in the First Circuit, both in the district and in the appellate courts, including the printed record and briefs of both parties, without any reservation, and when the said Court of Appeals for the First Circuit affirmed the lower court's decree on the issue of infringement,

appellant herein called the Primary Examiner by long distance telephone and informed him of it. So the said Primary Examiner, as well as the said Deputy Solicitor, had full and complete information before him when he allowed the later rejected claims.

STATUTES, RULES, AND REGULATIONS INVOLVED

Relevant parts of statutes, rules, and regulations involved not included in this brief are set out in separate appendices, beginning at page number 1(a) at the end of the brief and will be referred to by their respective alphabetical designations, such as (Appendix A), etc.

(Rule 17(b) (Rule 17(b)(6).

STATEMENT OF POINTS

(Additional to Points Stated in the Statement of Questions Presented, *Supra*)

1. Whether the District Court erred in holding that appellant herein had adequate remedy by appeal to the Board of Appeals of the Patent Office, where he had no such remedy, and the said holding is contrary to the evidence, and is not supported by the facts and circumstances of the case?
2. Whether the District Court erred in holding that the Acting Commissioner of Patents had discretionary power in matters complained of, where he had no such power, and the said holding is contrary to the evidence, and is not supported by the facts and circumstances of the case?
3. Whether the District Court's said holdings, set out in points one and two above, are contrary to the law, and are not sanctioned or supported by any of the patent statutes, rules, or regulations, or justified by any controlling case citations?
4. Whether under 5 U.S.C. 1009(e) (Appendix A) it was the duty of the District Court to "review the whole record or such portion

thereof as may be cited by any party, and" to take due account "of the rule of prejudicial error"?

5. Admitting that the Acting Commissioner of Patents had some measure of discretionary power under 35 U.S.C. 122 (Appendix C) to grant access to the reissue application under "special circumstances" whether such power extends to the abuse of discretion by secretly cooperating, or sanctioning such cooperation on the part of his office, with certain accused infringers? (See also Appendices G and H)

6. Admitting that under *Rule 313, Rules of Practice of the United States Patent Office* (Appendix K) an applicant may not, after the notice of allowance has been sent, the final fee paid, and the patent to be issued has received its date and number, withdraw his application from issue without the approval of the Commissioner, whether the Commissioner may withdraw such application from issue without the consent of applicant for any reason except because of fraud or illegality in the application, or for interference?

7. Assuming, *arguendo*, that under 1308.01, *Manual of Patent Examining Procedure* (Appendix M) there is some justification, where a new reason or a new reference has been discovered, on the part of the Patent Office, for the withdrawal of an application from issue after allowance, after a notice to the applicant of the intended withdrawal, giving him an opportunity to respond before such withdrawal, whether there is any justification, under the patent statutes, rules, or regulations, on the part of the Patent Office, arbitrarily and without any advance notice to the applicant, to withdraw an allowed application from issue without assigning any new reason or citing any new reference, but reciting only reasons which were before the Examiner when he allowed the claims (and the application) later rejected by him "merely by obeying orders"?

8. Whether it is within the sound discretionary power of the Commissioner of Patents to sanction the secret use of pressure, influence, representation, or inducement upon the Patent Office by accused infringers, and thereby effect the withdrawal of an allowed application from issue?

9. Whether appellant herein had any remedy by appeal to the Board of Appeals of the Patent Office where such appeal lies only on matters of patentability, which are not in issue herein, but not on matters set forth in the complaint, review of which matters may only "be had by petition to the Commissioner followed by Civil Action under 5 U.S.C. 1009"¹ (Appendix A), which is the procedure followed by appellant herein?

SUMMARY OF ARGUMENT

The District Court has erroneously held that appellant herein had a remedy by appeal to the Patent Office Board of Appeals, and that mandatory relief does not lie against the Commissioner of Patents for refusal to issue a patent since an appeal lies from such refusal (J.A. 21). On the basis of that holding, the District Court entered an order (J.A. 22) allowing defendant's motion to dismiss the complaint. The District Court was persuaded in that decision and order by an old (June 2, 1913) decision in *In re Moore v. United States ex Rel. Chott*, 40 App. D.C. 591 (hereinafter referred to as "the *Moore* case"). The *Moore* case, which was cited by defendant (appellee herein), basing his defense almost wholly upon it, is neither controlling in this case as a matter of law, nor is applicable thereto as a matter of fact and circumstances. The procedure in the Patent Office when the *Moore* case was decided was materially different as relates to appeals and petitions from what it is today. Nor do the facts and circumstances in the *Moore* case in any way correspond to

¹ See In re James Donald Walker, 327 F.2d 977; 139 USPQ 480 — CCPA, Dec. 12, 1963).

the facts and circumstances of this case. The District Court erred in making the said decision and order. The Acting Commissioner of Patents had no power under the facts and circumstances set out in the complaint, which stand as admitted in view of the motion to dismiss, to withdraw the said reissue application from issue, or to cooperate with the said accused infringers. Such conduct was grossly prejudicial to the appellant herein, and he is entitled to a review thereof under 5 U.S.C. 1009.

ARGUMENT

In the *Moore* case (*In re Moore v. United States ex Rel. Chott, supra*), the Court in the opinion stated the facts as follows:

"This is an appeal by E. B. Moore, the Commissioner of Patents, and A. G. Wilkinson, one of the Examiners of the Patent Office, as joint respondents, from the judgment of the supreme court of the District of Columbia ordering the issuance of a writ of mandamus to compel them to issue a patent to relator Edward L. Chott.

"It appears that relator applied for letters patent for alleged improvements in dental broach holders. The claims were rejected by the Primary Examiner, from whose decision relator appealed to the Board of Examiners-in-Chief. The board reversed the Primary Examiner, and sustained the claims. Acting by authority of the Commissioner, the Primary Examiner made an additional investigation, and cited to the Commissioner additional patents showing the alleged invention to be old. Whereupon the Commissioner personally took up the case, and approved the action of the Primary Examiner. He did not, however, finally reject the claims, but asserted in a communication to relator his authority to review the case personally, although it had been acted upon favorably by the Board of Examiners-in-Chief. He notified relator that on May 8, 1912, a hearing would be had upon the patentability of his claims over the prior art. Relator appeared by brief, contesting the authority of the Commissioner to withhold the application from issue after

a favorable decision from the Board of Examiners-in-Chief. The Commissioner, in a carefully considered opinion on the merits of relator's alleged invention, decided that relator was not entitled to a patent, and finally disallowed the claims."

From the foregoing statement of the facts by the court in the *Moore* case it will at once be seen that there are no comparable situations or circumstances between that case and this case. In the *Moore* case, for example, there was no allowance of the claims by the Primary Examiner (J.A. 15); there was no Notice of Allowance "By Direction of the Commissioner" (J.A. 16); there was no assignment of date and number for the patent to be issued (J.A. 17); there was no arbitrary withdrawal of the application from issue without giving any new reasons or citing any new references and without any advance notice to applicant (J.A. 17-18); there was no secret cooperation with accused infringers on the part of the Patent Office. These are but few of the many distinguishing points that can be mentioned, but they are quite enough to mark the distinction clearly.

The sole issue in the *Moore* case was whether the Commissioner had any power to by-pass or overrule the Board of Examiners in Chief and sustain the Primary Examiner in rejecting the claims. The Supreme Court of the District of Columbia, which was the court of original jurisdiction in the *Moore* case, certainly did not think so when it issued the writ of mandamus; and the Supreme Court of the United States had at least a doubt in the matter when it granted a writ of error on June 11, 1913 (See the *Moore* case, 40 App. D.C. 591, at 598, *supra*).

However, be that as it may, the decision in the *Moore* case is moot and has no bearing of consequence upon this case. When the *Moore* case was decided, the procedure in the Patent Office, particularly as relates to the Commissioner's role in the examination and allowance of applications for patents, was critically different from what it is today. At that time (1913) the Patent Office procedure included an applicant's right of

appeal from the adverse decision of the Primary Examiner to the Board of Examiners in Chief and from that body to the Commissioner, who was the authority of last resort in the Patent Office in the determination of issues of patentability, and an appeal to the courts would lie only from his adverse decisions.

A summary of the present Patent Office procedure as relates to matters on hand has been set out in the sub-paragraph Z(b) of the Introduction to the Fourth Edition (1960) of the *Rules of Practice of the United States Patent Office*, reading as follows:

"(b) If the final decision of the examiner is adverse to the granting of a patent, or any of the claims presented, the applicant may appeal to the Board of Appeals and is entitled to an oral hearing. From the decision of the Board of Appeals an appeal may be taken to the United States Court of Customs and Patent Appeals or a civil action may be brought against the Commissioner in the United States District Court for the District of Columbia. *Matters of form and procedure may be reviewed on petition to the Commissioner.*" (Italics added). (See also *Rules 191 to 198, 301, and 308 of the said Rules*. See also 35 U.S.C. 141-146).

A somewhat closer consideration of the present practice in the Patent Office shows that the Commissioner is only a member of the Board of Appeals where questions of patentability are concerned. His role therein is very much like that of a chief judge in an appellate court. When, if ever, he sits in a hearing by the Board, he has only one vote, and no veto power, nor is the decision on patentability questions reviewable by him when he does not sit. A right of review from such decision may only be taken to the courts. Matters not involving questions of patentability are reviewable by petition to the Commissioner, whose decision in turn is reviewable under 5 U.S.C. 1009, which is invoked by appellant herein in this case.

Nothing said herein should be construed as a claim by appellant herein that the power of the Commissioner has been curtailed in any way

since the *Moore* case was decided, but that under the present complex nature of the Patent Office his powers and duties are more clearly specified, and that no power ever resided in him in matters complained of herein for acting as ~~he~~ did in this case.

The District Court was clearly in error in dismissing the complaint, because:

1. There was no remedy by appeal to the Court of Customs and Patent Appeals in matters set out in the complaint, and in the statements of points and questions presented. In a recent (December 12, 1963) decision in *In re James Donald Walker, supra*, that Court, in referring to certain procedural matters presented in that case, said:

"We do not think it proper for us to act here in connection with either of those matters. Appellant has a remedy in the case where he thinks the Board improperly failed to designate a new rejection as such . . .

(Footnote)

The Solicitor suggests review of that matter 'might be had by petition to the Commissioner followed by Civil Action under 5 U.S.C. 1009' ".

2. Nor would appellant herein have had adequate remedy by waiving all relief in matters herein complained of and appealing on issues of patentability, since that course would have unreasonably delayed the issue of his patent, and since the filing of a reissue application does not operate to stop the running of the term of the original patent, and thereby his statutory seventeen year property right in the original patent would have been grossly depreciated and curtailed. Nor had appellant herein any assurance that by following such a course his application would not again be arbitrarily withdrawn from issue as before.

3. It is elementary that a remedy provided by law and rules must be full and complete in order to operate as a bar against the invocation of mandatory relief by an extraordinary writ. Nor is there any provision in civil law for any remedy against the arbitrary and capricious conduct of a public official other than by a resort to the substance of such a writ.

4. Appellee herein has claimed in the Court below, verbally and by brief "broad supervisory authority" or "discretionary power" under 35 U.S.C. Sections 6, 131, 122, and 251, which "authority" or "power" he, in effect, defines, as applied to this case, in terms of dictatorship, even stronger than the terms used by Lord Camden who defined "discretion . . . to be the law of tyrants; it is always unknown, it is different in different men; it is casual, and depends upon constitution, temper, and passion. In the best, it is oftentimes capricious; in the worst, it is every vice, folly, and passion to which human nature is liable." (*Delno v. Market St. Ry. Co.*, C.C.A. Cal., 124 F. 2d 965, 967).

"The exercise of 'discretion' does not permit the court (much less an administrative agency) to disregard the substantive principles of law established for protection of litigants, . . ." (*Cohen v. Young*, C.C.A. Mich., 127 F. 2d 721, 726).

"'Discretion' in a legal sense is the exercise of official conscience on all the facts of a particular situation in the light of the purpose for which the power exists." (*Reeves v. Pennsylvania R. Co.*, D.C. Del., 9 F.R.D., 487, 489)

5. Moreover, while defendant's conduct in this case involves gross abuse of discretion, your petitioner relies, principally or solely, upon Federal Statute which imposes a mandatory obligation upon defendant, such as Title 35 United States Code Sections 122, 131, and 251, and established procedure and rules formulated thereunder, containing the word "shall" in defining such obligation; and the following decisions are typical in this respect:

The use of "shall" in federal statute imposes a mandatory obligation. (*United States v. Ganz*, D.C. Mass., 48 F. Supp. 323, 327. See also *In re Koncus*, C.C.A. Ill., 123 F. 2d 92, 95).

"The word 'shall' in a statute is the language of a command." (*Brown v. Hecht Co.* (Dist. of Columbia), 137 F. 2d 692).

"The word 'shall' in statute is mandatory in term and may not be given merely directory meaning where the rights of private citizens are concerned." (*Triangle Candy Co. v. United States*, C.C.A. Cal., 144 F. 2d 195.)

"The word 'shall' is ordinarily imperative, of similar effect and import with the word 'must', and inconsistent with the idea of discretion." (*Pitman Const. Co. v. Housing Authority of Opelousas*, D.C. La., 168 F. Supp. 517, 523.)

The following state court decision is representative of decisions of other state courts:

"The word 'shall' used in statutes commonly imports imperative order and not precatory suggestion." (*McCarthy v. Boyden*, 275 Mass. 91.)

6. In view of the foregoing court definitions the word "shall" as used in statutes, 35 U.S.C. 131 (see paragraph 17 of complaint) imposes a mandatory obligation on defendant of causing an examination to be made of the application, and if found that applicant is entitled to a patent under the law (as it has been so found in this case) to "issue a patent therefor", which defendant has failed to do, and mandatory relief will clearly lie to compel him to perform his duty as herein prayed for.

7. For the same reasons 35 U.S.C. 122 imposes a mandatory obligation upon defendant to keep plaintiff's application in confidence, and "special circumstances" provided therein must be founded upon concrete evidence, and not upon a state of mind, or upon a concept of "discretion" such as defined by Lord Camden, *supra*, and which may be more appropriately defined as "dictatorship". Is that what Congress intended in enacting 35 U.S.C. 6? Believe it or not, defendant's claim of broad discretionary power as applied to this case smacks of a claim to just such a dictatorship. Such claim on the part of an administrative branch of the Federal Government is dangerous, and denotes such wide

departure from the accepted and usual course of administrative law and procedure as to call for the exercise of this Court's statutory power of review. (5 U.S.C. 1009).

8. Moreover, plaintiff's complaint herein is not predicated upon the wrong exercise of rightful discretion by defendant upon considering, after notice, petition and opposition therein, but upon his secret cooperation by a staff member (or members) in his office with the attorney (or attorneys) of certain accused infringers, which member (or members) has subjected himself to pressure, influence, inducement, and/or representations by said attorney (or attorneys) and has thereby caused the unlawful and otherwise unwarranted withdrawal of plaintiff's application from issue.

9. During the hearing on his motion to dismiss, appellee herein made the following request of the District Court:

"I would deny (dismiss), without specifically mentioning the allegations that plaintiff has made in his arguments".
(J.A. 21).

Appellant herein respectfully submits that a litigant cannot justly hope to escape responsibility by sweeping the facts under the rug, as it were.

CONCLUSION

Upon all the facts and law above set forth, the judgment of the District Court ought to be reversed, and the relief prayed for in the complaint be granted.

Respectfully submitted,
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Appellant
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Worcester, Massachusetts, 01601

APPENDICES TO APPELLANT'S BRIEF**STATUTES, RULES, AND REGULATIONS INVOLVED****APPENDIX A.**

Title 5, U. S. Code, Section 1009.

§ 1009. Judicial review of agency action

Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion.

Rights of review

(a) Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

Form and venue of proceedings

(b) The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

Acts reviewable

(c) Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial review. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the action meanwhile shall be inoperative) for an appeal to superior agency authority.

Relief pending review

(d) Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

Scope of review

(e) So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold unlawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 1006 and 1007 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error. June 11, 1946, c. 324, § 10, 60 Stat. 243.

APPENDIX B.**Title 35, U. S. Code, Section 6.****Sec. 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or *perform all duties required by law respecting the granting and issuing of patents and the registration of trade marks*; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, *not*

inconsistent with law, for the conduct of proceedings in the Patent Office. (Emphases added).

APPENDIX C.

Title 35, U. S. Code, Section 122.

Sec. 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. (Emphases added).

APPENDIX D.

Title 35, U. S. Code, Section 131.

Sec. 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor. (Emphases added).

APPENDIX E.

Title 35, U. S. Code, Section 251.

Sec. 251. Reissue of defective patents

* * * *, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, * * * * (Emphasis added).

APPENDIX F.

Title 35, U. S. Code, Section 112.

Sec. 112. Specification

* * * * *

An element in a claim * * * may be expressed as a means or step for performing a specified function without the recital

of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and *equivalents* thereof. (Emphasis added).

APPENDIX G.

Rule 14(a), Rules of Practice of the United States Patent Office.

14. Patent Applications Preserved in Secrecy. (a) Pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority of the applicant or his assignee or attorney or agent, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

APPENDIX H.

Rule 291, Rules of Practice of the United States Patent Office.

291. Protests to the Grant of a Patent. The patent statutes do not provide for opposition to the grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

APPENDIX I.

Rule 311, Rules of Practice of the United States Patent Office.

311. Notice of Allowance. If, on examination, it shall appear that the applicant is justly entitled to a patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of the final fee * * *. In cases in which no final fee is due * * *, the patent will be prepared for issue in *due course* after the notice of allowance is sent. (Emphasis added).

APPENDIX J.

Rule 312, Rules of Practice of the United States Patent Office.

312. Amendments after allowance. Amendments after the notice of allowance of an application will not be permitted as a matter of right, *but may be made*, if the printing of the specification has not begun, on the recommendation of the primary examiner, approved by the Commissioner, *without withdrawing the case from issue*. (Emphases added).

APPENDIX K.

Rule 313, Rules of Practice of the United States Patent Office.

313. Withdrawal from issue. After the notice of allowance of an application is sent, *the case will not be withdrawn from issue* except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed. *When the final fee has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue* on account of any mistake or change of purpose of the applicant, his attorney or his agent, * * *, *nor for any other reasons* except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. (Emphases added).

APPENDIX L.

Chapter 100, Manual of Patent Examining Procedure. (M.P.E.P.)

104. Power to Inspect Application

No person except the applicant, the assignee whose assignment is of record, or the attorney of record will be permitted to have access to the file of any application, except as provided for under the interference rules, unless written authority from the applicant, assignee, or attorney, identifying the application to be inspected, is filed in the case to become a part of the record thereof, or upon the written order of the Commissioner, which will also become a part of the record of the case. (Basis: Order No. 1271.)

* * * * *

Permission to inspect given by the Commissioner, however, is not of a continuing nature, since the conditions that justified the permit to inspect when given may not obtain at a later date.

APPENDIX M.

Chapter 1300, Manual of Patent Examining Procedure. (M.P.E.P.)

1308.01 Rejection after Allowance.

* * * * *

*When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, * * *, the Examiner is authorized to enter a letter informing applicant the proposal of requesting withdrawal from issue for the purpose of rejecting the claim or claims as fully met by, or obviously unpatentable over, the new reference. The letter should apply the reference in detail and should also set a time limit (within the statutory period), within which applicant may respond by way of argument or amendment under Rule 312 to overcome the reference and avoid the necessity for withdrawal from issue. Such a letter, with the reference and file, should be submitted to the Supervisory Examiner before mailing.* (Basis: Notice of March 15, 1950.) (Emphasis added).

APPENDIX N.

Chapter 1300, Manual of Patent Examining Procedure. (M.P.E.P.)

1308.02. Form of Letter

Where it becomes necessary to withdraw a case from issue for the purpose of rejecting claims, the following letter, sent to the appropriate Director, will serve as a form:

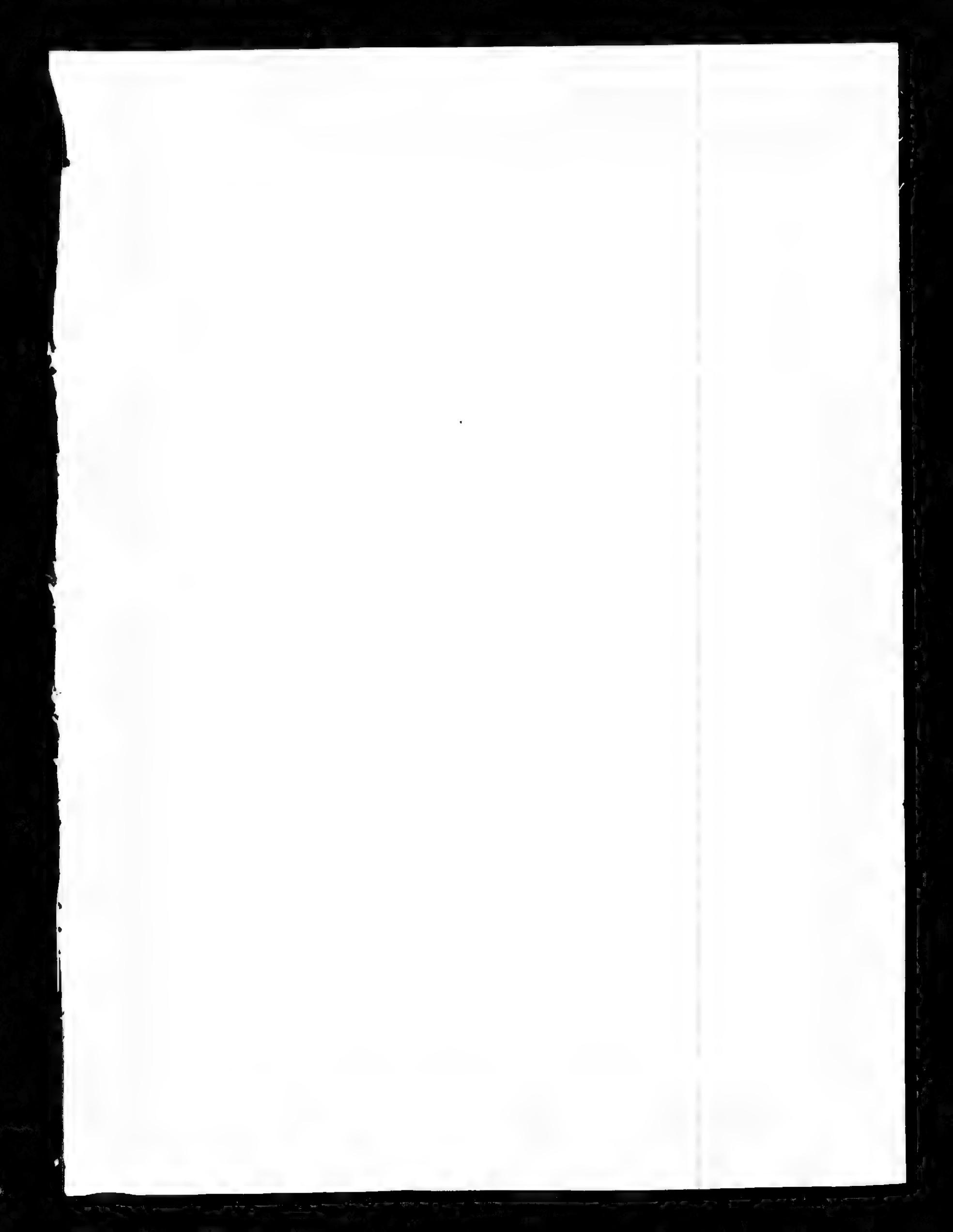
* * * * *

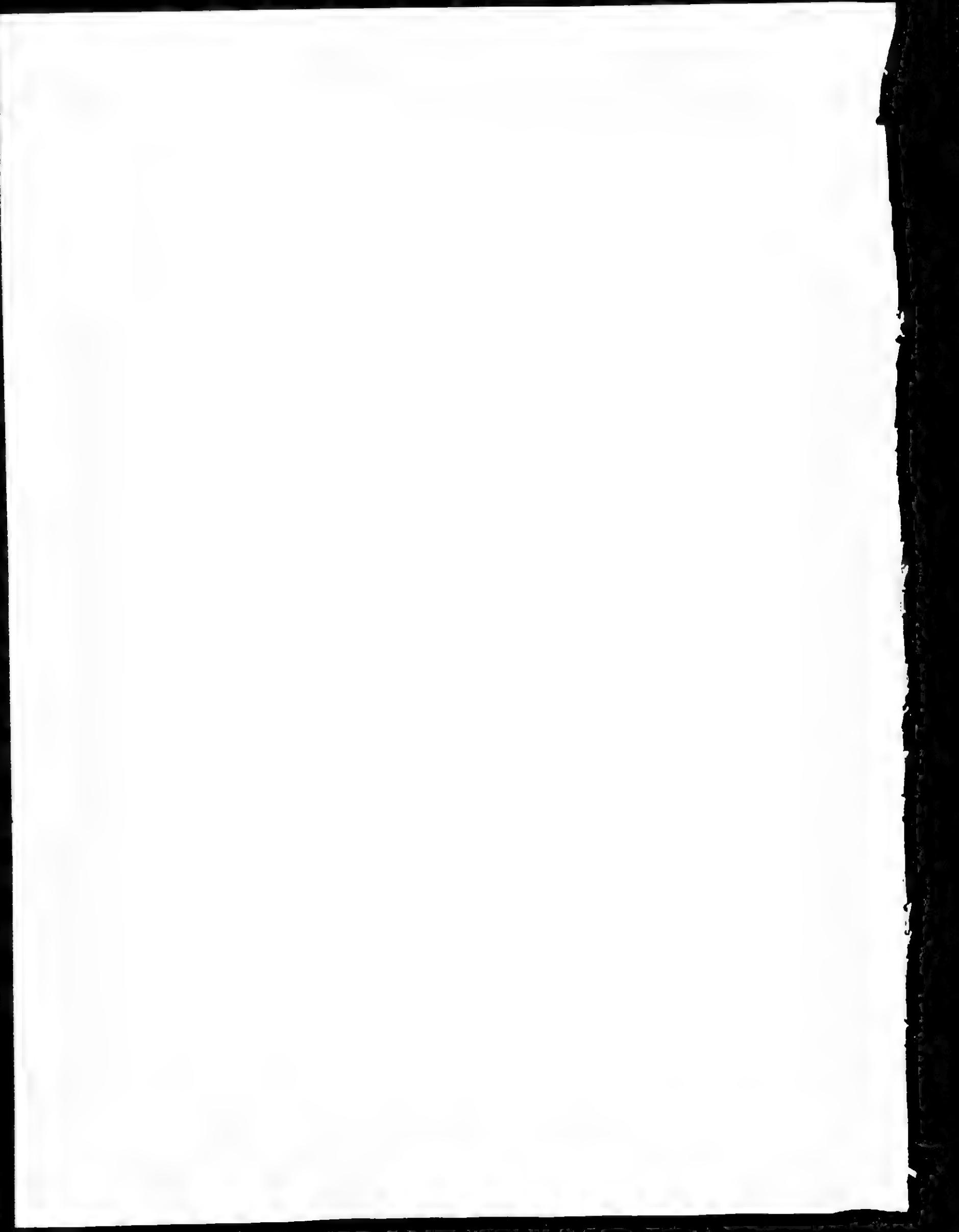
Director, Patent Examining Operation:

Sir: It is requested that the above-entitled application be withdrawn from issue for the purpose of rejecting claims *in view of the newly discovered reference*, the patent No. _____ to _____ (Explain if necessary)

* * * * *

(Emphasis added).





(i)

INDEX

	<u>Page</u>
Relevant Docket Entries	1
Complaint for Mandatory Relief, Filed December 28, 1963	2
Plaintiff's Exhibit A -- Patent No. 2,804,395	10
Plaintiff's Exhibit B -- Supplemental Oath, in the United States Patent Office, dated October 28, 1963	14
Plaintiff's Exhibit C -- Communication from Examiner to Mr. Boyajian dated October 21, 1963	15
Plaintiff's Exhibit D -- Notice of Allowance, Dated November 15, 1963	16
Plaintiff's Exhibit E -- Final Fee Receipt	17
Plaintiff's Exhibit F -- Communication from the Examiner to Mr. Boyajian dated December 4, 1963	17
Defendant's Motion to Dismiss Complaint, Filed February 19, 1964	19
Excerpts from Transcript of Hearing on Motion to Dismiss, March 13, 1964	20
Order of Court Dismissing Complaint, Filed March 16, 1964	22
Notice of Appeal, Filed May 15, 1964	22



JOINT APPENDIX

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

SETRAK K. BOYAJIAN,
P.O. Box 973
Worcester, Mass., 01601,
Plaintiff,
v.
EDWIN L. REYNOLDS, Acting
Commissioner of Patents,
United States Patent Office,
Washington, D.C. 20025,
Defendant.)
)

Civil Action No. 3088-63

RELEVANT DOCKET ENTRIES

<u>Date</u>	<u>Proceedings</u>
<u>1963</u>	
Dec. 28	Complaint, appearance in P.P. and Exhibits A-F, inclusive-filed
Dec. 28	Summons, copies (3) and copies (3) of Complaint issued Ser. 12-30-63 Atty. Gen. ser. 1-2-64; U.S. Atty. ser. 12-30-63
<u>1964</u>	
Jan. 3	Amendment to petition. filed
Feb. 19	Motion of deft. to dismiss; P&A; c/m 2/19/64; exhibits X & Y; MC 2/19/64; appearance of C.W. Moore, Solicitor * * * filed
Feb. 29	Opposition of pltf. to motion to dismiss; c/m 2/28/64 * * * filed
Mar. 9	Request of pltf. for rulings against deft's motion to dismiss; c/m 3/7/64 * * * filed
Mar. 16	Decision by the Court. (Court's copy) (Rep. Maher) * * * filed
Mar. 16	Order granting motion to dismiss and dismissing complaint. (N) Jackson, J.
Mar. 23	Transcript of proceedings 3/13/64, pp. 1-39. (Rep. Maher) (Court's copy) * * * filed
Mar. 30	Motion of pltf. for an opinion on the order dismissing com- plaint; c/m 3/28/64 * * * filed

<u>Date</u>	<u>Proceedings</u>
Apr. 6	Order denying deft's motion for an opinion on order dismissing complaint (N) - Jackson, J.
Apr. 7	Comments by deft on motion for an opinion on order to dismiss; c/m 4/6/64 * * * filed
May 15	Notice of Appeal * * * filed
June 2	Transcript of Proceedings

[Filed December 28, 1963]

COMPLAINT FOR MANDATORY RELIEF

* . * * *

1. This Court has jurisdiction over the parties and issues herein under 5 U.S.C. 1009, and 28 U.S.C. 1651(a). (See also Commisariat A L-Energie Atomique v. Watson, 274 F.2d 594.)

2. Your petitioner, Setrak K. Boyajian (hereinafter called "petitioner"), is an individual, having as his post office address P.O. Box 973, Worcester 1, Massachusetts. The respondent, the Honorable Edwin L. Reynolds, is the Acting Commissioner of Patents (hereinafter called "Commissioner") and has as his official address the United States Patent Office, Washington 25, D.C.

3. Your petitioner is the original and first inventor of certain new and useful improvements in envelopes entitled envelopes and the like with remoistenable adhesive comprising polyvinyl alcohol.

4. On the 4th day of September, 1953, in the manner prescribed by law, your petitioner presented his application to the United States Patent Office praying that a patent be issued to him for the said invention.

5. Such proceedings were had in said Patent Office upon said application that on August 27, 1957, a patent was issued to your petitioner thereon as also prescribed by law, said patent being numbered 2,804,395 in said Patent Office. (A certified copy of said patent is hereto appended marked "Exhibit A").

6. On June 9, 1959 -- well within two years from the date of the issue of said patent -- your petitioner presented, also in the manner prescribed by law, his application to the said Patent Office praying that said patent be reissued to him on the ground principally of its being partly inoperative by reason of patentee having claimed less than he had the right to claim. Other grounds are stated in a Supplemental Oath subsequently filed. (A certified copy of said Supplemental Oath is hereto appended marked "Exhibit B").

7. Some four months after the issuance of said (original) patent, namely, on December 30, 1957, certain accused infringers filed in the United States District Court for the District of Massachusetts a petition for declaratory judgment against your petitioner alleging invalidity and non-infringement of said patent. Your petitioner counterclaimed, charging plaintiffs with infringement, seeking damages and demanding a trial by jury of all issues triable as of right by a jury. Thereafter, namely, on September 16, 1959, the said district court allowed plaintiff's motion for summary judgment by declaring all claims of said original patent (2,804,395) invalid.

8. Defendant in said district court case (your petitioner herein) appealed to the United States Court of Appeals for the First Circuit, whereupon, namely, on June 14, 1960, that Court reversed the decision of said district court and vacated its decree of invalidity. There has not been any trial on the merits in said district court case involving the said original patent (although it is now nearly six years old), and the summary proceedings therein have for the past three years been directed to the issues of infringement; so that, as the case now stands, eight claims (out of ten), including Claim 1, which are the only claims from the said original patent now in the said reissue application, have been found by both the said district court (Massachusetts) and by the said Court of Appeals (First Circuit) presumably valid.

9. The following basic facts will enable this Honorable Court better to understand the nature of issues involved: Your petitioner's

invention itself is of basic and pioneer magnitude. It has revolutionized the industry. Before such invention polyvinyl alcohol was totally useless as an essential ingredient in an envelope seal flap remoistenable adhesive coating composition. There is no "prior art" as patent law contemplates it, and any reference to what went before as prior art is in this case an obvious mistake. The invention is for a physical structure. There are no process claims either in the said original patent or in the said reissue application. Your petitioner set forth the boiling as the best mode contemplated by him for carrying out his invention at the time it was reduced to practice. (35 U.S.C. 112 -- first paragraph). The expressed purpose of the boiling was to render the polyvinyl alcohol substantially pure, free of all volatile contaminants, and homogeneous throughout. This did not preclude him from the use of other or equivalent means to obtain the same or equivalent results. (Deering v. Winona Harvester Works, 155 U.S. 286, at 297-298, 302). Your petitioner wishes respectfully to point to this Honorable Court that nothing said in this paragraph is to be construed as an argument on the merits of his invention, for such merits are not in issue in this petition: they were settled when the application was allowed and sent to issue, as it will be seen hereinafter.

10. Concurrently with his prosecution of the said Court case, your petitioner vigorously prosecuted his said reissue application in the Patent Office (serial numbered therein 818,990), and on October 23, 1963, the Principal Examiner, having all of the proceedings in the said court case before him, and substantially by virtue thereof, issued an Office Letter (designated as Paper 49) allowing every claim (17 in all) in said reissue application, and further stating: "This case will be passed to issue in due course". (A certified copy of said Office Letter is hereto appended marked "Exhibit C").

11. Thereafter, namely, on November 15, 1963, a formal NOTICE OF ALLOWANCE was issued, giving the issue date of the reissue patent as December 31, 1963. (A certified copy of said NOTICE OF ALLOWANCE is hereto appended marked "Exhibit D"). Shortly (a day or two) thereafter

a pink slip was received from the Patent Office informing your petitioner that the number assigned to the reissue patent is RE 25504. (A photocopy of said pink slip is hereto appended marked "Exhibit E").

12. Fully relying on the foregoing documents, your petitioner was preparing to receive his reissue patent as scheduled, when he received another Office Letter from the Patent Office, dated December 4, 1963 and designated as Paper No. 54, over the signature of said Principal Examiner, informing your petitioner that the said reissue application had been withdrawn from the Issue Branch for the purpose of rejecting six of the seventeen claims allowed. (A certified copy of said Office Letter of December 4, 1963, is hereto appended marked "Exhibit F").

13. Your petitioner telephoned, on December 6, 1963, the said Principal Examiner who informed him that he had signed the request for withdrawal of the allowed application from issue and had rejected the six allowed claims only in obedience to orders from the Acting Commissioner or from the Deputy Solicitor in his name, and not because he believed them to be not allowable, and that he still believes them to be allowable.

14. Your petitioner respectfully submits that all of the grounds for rejection stated in said Office Letter of December 4, 1963 were before the said Principal Examiner when he allowed the said claims and sent the said application to issue, and no new grounds by way of reference or otherwise were cited in making the rejection of the allowed claims. In addition, a part of the quotation from the District Court's memorandum refers to matter in a previous decision of that court which had been reversed. Even so, that, too, was before the Principal Examiner when he sent the application to issue. As already pointed out, all of the stated grounds for the rejection in said Office Letter of December 4, 1963, were deemed by the Principal Examiner (who, your petitioner believes, still so deems) as valid grounds for the allowance when he sent the application to issue.

15. Throughout the course of the prosecution of said reissue application in the Patent Office the attorney for the accused infringers in the said court case was unlawfully permitted, unbeknown to your petitioner, to prosecute a case against granting the reissue patent, by the said Deputy Solicitor of the Patent Office acting in the name of the Commissioner, thus seriously, at times irreparably, interfering, tortiously, with the ex parte prosecution of your petitioner's reissue application to his great damage and injury.

16. In the present instance, your petitioner has good and sufficient reason to believe, and he does believe, and so aver and offer to prove that his said allowed reissue application was withdrawn at the instigation and on behest of said attorney for the accused infringers who was thus permitted to supersede the Principal Examiner in measuring the standards of patentability. Your petitioner prays this Honorable Court for leave to make discovery on this and on other points that may be in issue, by deposition and otherwise.

17. And yet, apart from all these, the conduct of the said Acting Commissioner of Patents in this case involves the open violation of a Federal Statute, namely, 35 U.S.C. 131, which reads as follows:

"The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner SHALL issue a patent therefor." (Emphasis added).

18. The foregoing statute is fully mandatory, and does not leave any room for discretion. The reissue application herein (now more than four and a half years old) having been examined and found that the applicant is entitled to a patent, which fact is all a matter of record, mandamus will, your petitioner respectfully submits, lie to compel the said Acting Commissioner to issue, and/or cause or permit the issue of said reissue patent forthwith, and without any delay, and refrain from any interference with the orderly course of such issue.

19. The said Acting Commissioner's conduct in this case is in violation of another Federal Statute, namely, 35 U.S.C. 122, which reads as follows:

"Applications for patent shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

In this case, your petitioner respectfully submits, information concerning the said reissue application was given freely and continuously by the Patent Office to the said attorney for the accused infringers in the said court case, and the case itself was "reviewed" with him.

20. On December 9, 1963, during an office interview your petitioner called upon the said Acting Commissioner in person to cause the immediate return of said reissue application to the Issue Branch of the Patent Office for the issue of the patent as originally scheduled. The Acting Commissioner informed your petitioner during the said office interview that he had approved the said withdrawal on the representations of said Deputy Solicitor, but that he (the Acting Commissioner) believed that said application might forthwith be sent back to the Issue Branch on some formal changes in the rejected claims (previously allowed) without impairing their scope in any way.

21. But on December 11, 1963, the said Acting Commissioner changed his mind, due to, your petitioner believes, further representations by the said Deputy Solicitor, and referred your petitioner to the Supervising Examiner of Group 140. Thereupon your petitioner filed (on said December 11, 1963) and presented to the Acting Commissioner's office the following petition:

"The above named applicant hereby petitions the Acting Commissioner to return forthwith the above-entitled application to the Issue Branch of the Patent Office for issue in due course.

"(The above petition was verbally made and was denied.
This written petition is for the record.)"

22. Thereupon your petitioner received the following communication, dated December 12, 1963, and rubber stamped "EDWIN L. REYNOLDS" as "First Assistant Commissioner", reading as follows:

"This is a petition requesting that the above-entitled application be returned to the Issue Branch of the Patent Office for issue in due course.

"This application was withdrawn from issue on the request of the Examiner, approved by the supervisor and director, for reason that certain of the claims were not considered to be patentable, and a rejection of such claims has now been made. Under these circumstances, the case is clearly not in condition for the issuance of the patent and the petition is accordingly denied."

22. Thereafter, namely, on or about December 14, 1963, your petitioner transmitted to the said Acting Commissioner a memorandum in response to said communication, reading as follows:

"Applicant begs leave to take strong exceptions to the Acting Commissioner's statements in his communication of December 12, 1963 of the alleged facts in issue for the oft-repeated reasons that (a) the Examiner was merely obeying orders in requesting the withdrawal (b) there are no issues of 'Patentability' in the motivation of said withdrawal and (c) the Principal Examiner allowed and sent the application to issue under direct and active supervision, and by the express approval, of the Deputy Solicitor and the Supervising Examiner; and no amount of temporization on the part of the Acting Commissioner will change these facts, nor to abate in any way the seriousness of the matter."

23. Your petitioner respectfully submits that the said now rejected claims were introduced and claimed during office interviews with the

Principal Examiner in the presence of the said Deputy Solicitor who approved them as allowable before the case went to issue; and the said Principal Examiner has stated to your petitioner that he has consulted his Supervising Examiner in every step of the way during his examination of the said application. Your petitioner further submits that it is not the sense of patent law that an application may be withdrawn from issue for the sole purpose of aiding and abetting accused infringers, as in this case.

24. All in all, the conduct of the Acting Commissioner of Patents in withdrawing, or giving sanction to the withdrawal of, your petitioner's said reissue application from issue is arbitrary and capricious and otherwise not in accordance with the law, and in excess of statutory jurisdiction, authority or limitation, and your petitioner is lawfully entitled to mandatory relief therein from this Honorable Court.

WHEREFORE, your petitioner prays:

I. That a writ of mandamus be issued out of this Honorable Court directing and commanding the Honorable Edwin L. Reynolds, Acting Commissioner of Patents, forthwith to return the said reissue application (serial No. 818,990 -- June 9, 1959) to the Issue Branch of the United States Patent Office and direct and cause the issuance of the reissue patent in due course and without any further interference therein.

II. That a writ of mandamus be issued out of this Honorable Court directing and commanding the said Honorable Edwin L. Reynolds, Acting Commissioner of Patents, to keep the said reissue application in confidence while it is pending in the Patent Office and not to give out information concerning the same without authority in writing from your petitioner as provided by 35 U.S.C. 122; nor to permit the outside interference with the ex parte prosecution of said reissue application.

III. For such other and further relief as in law and in justice may thereto appertain.

Respectfully submitted,

/s/ Setrak K. Boyajian,
SETRAK K. BOYAJIAN, Petitioner

Plaintiff's Exhibit A.

10

Aug. 27, 1957

S. K. BOAJIAN
ENVELOPES AND THE LIKE WITH REMOISTENABLE
ADHESIVE COMPRISING POLYVINYL ALCOHOL
Filed Sept. 4, 1953

2,804,395

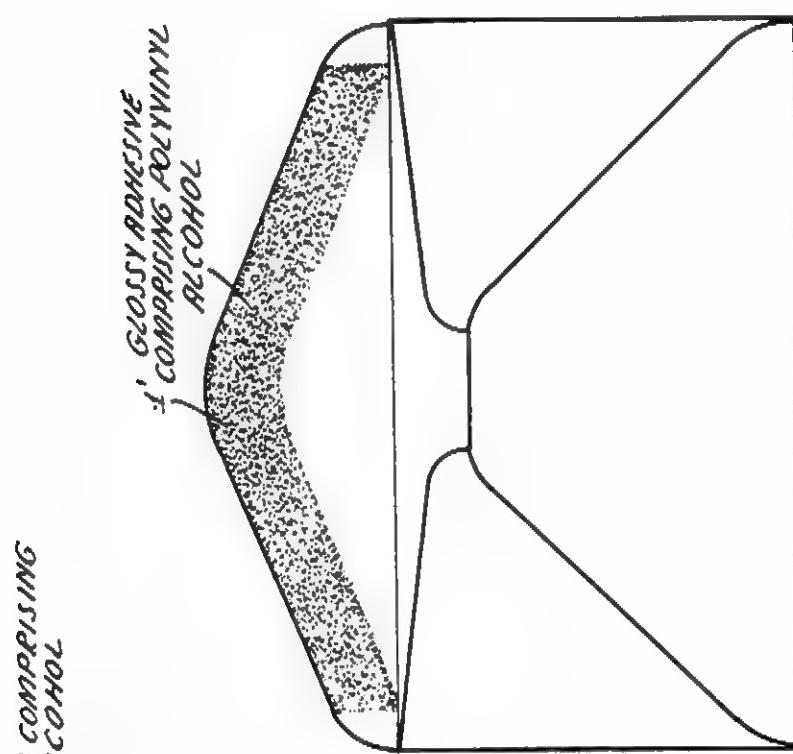


FIG. 2.

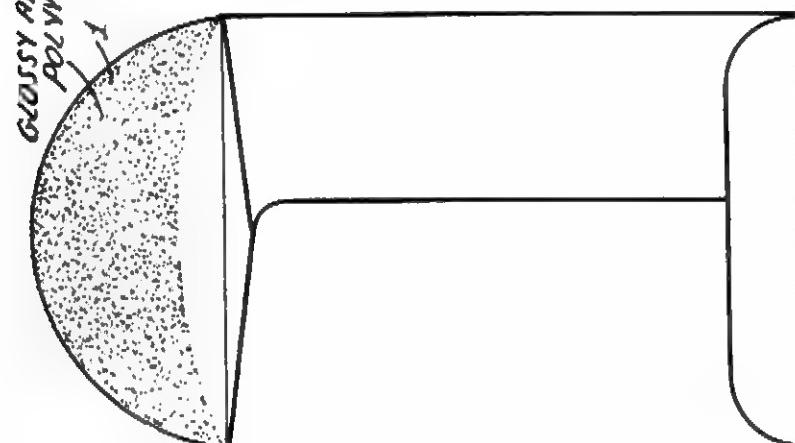


FIG. 1.

Sethak K. Boyajian
INVENTOR

United States Patent Office

2,804,395

Patented Aug. 27, 1957

1

2,804,395

ENVELOPES AND THE LIKE WITH REMOISTENABLE ADHESIVE COMPRISING POLYVINYL ALCOHOL

Setrak K. Boyajian, Worcester, Mass.

Application September 4, 1953, Serial No. 378,683

10 Claims. (Cl. 117—44)

My invention relates to envelopes having remoistenable 15 gummed seal flaps, gummed paper, postage stamps, labels, and the like.

Hitherto, envelope seal gum has, almost exclusively, consisted of dextrin, in its numerous modifications, by itself in water, or in mixture with acids, alkalies, solvents, and plasticizers, according to the kind of paper it was designed to stick. But dextrin by itself forms, upon drying from its watery solution, a very brittle and distorted film which soon begins to check and crack, and lose much of its adhesive properties even for very soft and easy to stick papers; and when mixed with, or reacted upon by, the materials and chemicals above mentioned, it will, while freeing itself from some of the foregoing objections, acquire thereby numerous other objectionable features, such as discoloring the paper and giving the gum an unwholesome taste, so that, before my invention, the envelope industry had openly recognized the fact that a fully satisfactory envelope seal gum did not exist, particularly for the sticking of harder papers, such as bond, kraft, etc.

One object of my invention is to provide an envelope seal flap that is free of all the materially objectionable features of hitherto produced envelope seal flaps.

A second object of my invention is to provide an envelope seal flap that will firmly and permanently stick all grades of envelope paper, whether soft or hard, including bond, kraft, linen and others of greater or lesser hardness, without the aid of acids, alkalies, or solvents.

A third object of my invention is to provide an envelope seal flap that is free of any odor, and one that possesses a wholesome, pleasant taste.

A fourth object of my invention is to provide an envelope seal flap that is non-checking, non-cracking, and non-curling, and one that will lie smoothly flat, while unsealed, over the body of the envelope without the aid of any chemical plasticizers.

A fifth object of my invention is to provide an envelope seal flap that is materially colorless permanently, and one that will not materially stain or discolor regardless of the kind of paper used in making the envelope.

A sixth object of my invention is to provide an envelope seal flap that is highly resistant to, and is not materially affected by, atmospheric conditions, such as high humidity and extreme dryness, and one that is materially non-blocking; also an envelope seal flap that will, after it has been sealed down, neither "wet-out" by atmospheric moisture and come open, nor "dry-out" by extreme atmospheric dryness and also come open, but will remain firmly stuck under all climatic conditions.

A seventh object of my invention is to provide an envelope seal flap that will not materially lick-out or wash-out in remoistening, and one that will not materially clog the wetting blade or wetting brush of the envelope sealing machine.

An eighth object of my invention is to provide an envelope seal flap that will adhere down quickly upon being remoistened and closed down.

2

A ninth object of my invention is to provide an envelope seal gum that will run clean on the applicable envelope machines as they now exist, or as may be designed and developed in the future.

5 A tenth object of my invention is to provide an envelope seal flap which possesses a combination of all the properties enumerated in the foregoing objects, together with other desirable properties incidental thereto and coexisting therewith; an envelope seal flap so combining these properties having been only a wishful thinking on the part of the envelope industry, never having been achieved before my invention.

An eleventh object of my invention is to provide an envelope seal gum which is, its higher qualities notwithstanding, economical because it will give greater "mileage," requiring both a thinner and narrower film for highly effective sticking. Other objects of my invention will appear hereinafter.

Referring to the drawings, Figures 1 and 2, respectively, illustrate open-end and open-side envelopes of the conventional design, showing the seal flaps having on the marginal portions thereof a layer of remoistenable adhesive coating composition having as its essential ingredient polyvinyl alcohol, as shown at 1, and 1', and 20 as it is described hereinafter.

25 With the above-enumerated objects as the goal, it was long since found by this applicant that sources other than dextrin or other starch gums must be brought into use for the production of a completely satisfactory envelope seal 30 gum. A water soluble plastic with a high tensile strength and structural stability seemed to be the answer, and polyvinyl alcohol appeared to be the most promising material for the purpose. But polyvinyl alcohol, even in its most advanced methods of production, is not a sufficiently pure product in its raw state so that it may be employed as an envelope seal gum: for, while given types of polyvinyl alcohol have been offered as remoistenable adhesive, this applicant has found that even extremely small quantities of contaminants will have a very decisive influence upon the permanence of the remoistenable 35 ability of such adhesives, and even if this condition is permissible for some uses, an envelope seal is not one of them, for if the seal flaps of a lot of envelopes become non-remoistenable as time passes, then it becomes so much scrap paper, unless the seal flaps can be regummed, at an almost prohibitive expense, and the envelopes sold as seconds at greatly reduced prices.

It was, at the time, believed that if the permanence of 40 remoistenable polyvinyl alcohol could satisfy the need for a long sought-after completely suited envelope seal 45 gum, as it seemed to possess all of the remaining properties needed for the purpose. It was also believed that the said selected grade could be made into a permanently remoistenable envelope seal gum if it was freed from the aforementioned contaminants. Consequently, all efforts were focused in that direction for the time being.

But when, after an exhaustive investigation, the desired 50 purity of the selected remoistenable polyvinyl alcohol was obtained, it was found that the resultant gum, while a decided improvement over the hitherto existing envelope seal gums, fell somewhat short of achieving the full combination of the objects hereinbefore 55 enumerated. For example, while, when purified the remoistenable 60 ability was made more permanent, the resultant gum showed considerable operating instability, varying from lot to lot of the raw product, and even from batch to batch of the water solution from the same lot of the raw 65 product—in tack, in running and sticking properties, in viscosity, etc.

Yet with all these, remoistenable polyvinyl alcohol still

2,804,895

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held the biggest promise for an ideal envelope seal gum. Its lack of operating stability as well as uniformity was the first drawback to be overcome. It was then found that while the selected remoistenable polyvinyl alcohol as such did not wholly combine all of the properties desired for an ideal envelope seal gum, some of its modifications, chemical or physical, would do so.

Chemically, hitherto starch, dextrin, and casein have been suggested as extenders, and glycerin and glycols as plasticizers, for polyvinyl alcohol. Several processes of sulphating and borating of polyvinyl alcohol have been patented. Another patent covers a remoistenable adhesive with a complex formula containing sulphite waste, wetting agent, polyvinyl alcohol, aluminum sulphate and water. None of the above processes and formulas have reported the use of polyvinyl alcohol, pure or modified, as an envelope seal gum, nor have others within my knowledge before my invention.

An envelope seal gum, above all, has to lend itself to automatic operation, as well as compatibility with a large variety of hard-to-stick, color sensitive, papers. It must, for example, possess sufficient tack, but must not materially cotton or string in operation, and possess all of the properties suggested in the objects hereinabove. These ends, I found, could be best realized with a product of extreme structural simplicity and integrity. It was then found that these properties could be obtained by selecting cane sugar as the chemical modifier and boiling, in aqueous solution, as the physical modifier.

For example, one hundred pounds of dry remoistenable polyvinyl alcohol of approximately eight cps. viscosity and one hundred and thirty saponification number is dissolved in three hundred and fifty pounds of hot water in a suitable jacketed kettle, with a moderately low-speed mixer, and the temperature is brought up to slow boiling and kept there under slow agitation for approximately one hour, and as long thereafter as needed for the complete disappearance of all the lumps, if any, and a uniform solution results, with all the volatile impurities distilled off therefrom. Thereupon one hundred pounds of granulated cane sugar is gradually added and digested in the batch and the temperature is brought to two hundred degrees F., or slightly under, and kept there for about ten minutes; then the heater and the mixer are turned off.

Where the desired structural simplicity, integrity, and workability of the polyvinyl alcohol solution is obtained by the boiling alone, then cane sugar may be omitted.

It must be remembered that the foregoing procedures and formulas are only examples, and admit wide degrees of variations, polyvinyl alcohol in each case being an essential ingredient, and admit further additions.

The envelope seal gum herein described is also ideal for coating paper, as well as gummed labels, postage stamps, and gummed tapes.

Various grades and brands of polyvinyl alcohol differ so widely in their inherent properties that often there appears nothing common among them other than the name. This difference often occurs even among the various lots of the same brand and grade, though in a lesser degree. The difference is more often physical than chemical. The former is chiefly structural; the latter is largely in the nature and quantity of the contaminants. The want of uniformity may or may not be important depending upon the use the polyvinyl alcohol is to be put to. For the purpose of this invention uniformity is critical. Published descriptive data, often dealing with a single sample, have at times furnished false leads for specialized objective investigation. For example, during my investigations in the interest of this invention I was frequently reminded by such descriptive data that when subjected to boiling temperatures an aqueous solution of polyvinyl alcohol would jell upon cooling. I found that while some samples of polyvinyl alcohol in 22.5% initial aqueous solution would if heated to 100

degrees C. jell on cooling, when such solution is brought to actual boiling and kept there for one hour or more, under agitation, so as to distill off all of its volatile contaminants, and precipitate all of its solid contaminants,

5 while also breaking up the nesting or clustering of molecules or particles, a near clear, free-flowing, and viscous solution will, after settling out and cooling, result. Such boiling will give to polyvinyl alcohol a lustrous, structurally stabilized, integrated, homogenized, quicker-adherent upon remoistening, non-jelling and free-flowing while in solution, more resistant to humidity, more responsive to applied moisture, smoother, clearer, and more flexible film-forming, and quicker-drying character. Such boiling will not only provide uniformity among 10 various lots of the same brand and grade of polyvinyl alcohol so as to give its solution a high degree of workability, even without the addition of cane sugar, but will also narrow down the hereinbefore mentioned barriers among its various brands and grades. After the first hour of prolonged boiling, there are varying degrees of increase in the tensile strength of the dry film of polyvinyl alcohol—thereafter, there is no notable change. This increase is perhaps due to molecular, particular, and/or structural integration.

25 I claim:

1. An envelope having on the underside of the marginal portions of the seal flap thereof a glossy layer of remoistenable adhesive coating composition having as its essential ingredient polyvinyl alcohol, said layer being 30 non-curling, non-blocking, non-staining, non-checking, and permanently responsive to applied moisture at any temperature, and having a wholesome, pleasant taste, and quick adherence upon remoistening and which has been deposited from homogeneous free flowing solution.

2. An envelope having on the underside of the marginal portions of the seal flap thereof a glossy layer of remoistenable adhesive coating composition having as its essential ingredient polyvinyl alcohol which has been boiled in aqueous solution for approximately one hour and until 40 all the lumps have disappeared and a near-clear homogeneous solution has been formed, with all volatile contaminants distilled off therefrom.

3. An envelope having on the underside of the marginal portions of the seal flap thereof a glossy layer of remoistenable adhesive coating composition having as its essential 45 ingredient polyvinyl alcohol which has been boiled in aqueous solution for a time sufficient to give it a lustrous, structurally stabilized, integrated, homogenized, quicker adherent, non-jelling and free-flowing while in cooled solution, more resistant to humidity, more responsive to applied moisture, clearer, smoother, stronger, and more flexible film-forming, and quicker-drying, character.

4. An envelope having on the underside of the marginal portions of the seal flap thereof a glossy layer of remoistenable adhesive coating composition having as its essential 55 ingredient polyvinyl alcohol which has been boiled in aqueous solution by dissolving in hot water in a suitable jacketed kettle having a mixer and bringing the temperature to boiling and keeping it there under agitation 60 for approximately one hour or until all the lumps have disappeared and a near-clear, homogeneous solution has been formed, with all volatile contaminants distilled off therefrom.

5. An envelope as claimed in claim 4 wherein cane sugar has been added to the hot aqueous solution of polyvinyl alcohol at the conclusion of said boiling.

6. As an article of manufacture, paper having on one side thereof a glossy layer of remoistenable adhesive 70 coating composition having as its essential ingredient polyvinyl alcohol which has been boiled in aqueous solution for a time sufficient to give it a lustrous, structurally stabilized, integrated, homogenized, quicker adherent, non-jelling and free-flowing while in cooled solution, more 75 resistant to humidity, more responsive to applied moisture,

2,804,395

5

clearer, smoother, stronger, and more flexible film-forming, and quicker-drying, character.

7. The article claimed in claim 6 wherein said paper comprises a postage stamp.

8. The article claimed in claim 6 wherein said paper comprises a label.

9. The article claimed in claim 6 wherein said paper comprises a gummed tape.

10. The article claimed in claim 6 wherein cane sugar has been added to the hot aqueous solution of polyvinyl alcohol at the conclusion of said boiling.

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Del Monte: Technology of Adhesives, 1947, pages 127, 128, 140.

[Plaintiff's Exhibit B]

IN THE UNITED STATES PATENT OFFICE

APPLICANT: SETRAK K. BOYAJIAN)
SERIAL NO : 818,990 (REISSUE)) HIGH POLYMER
FILED ON : JUNE 9, 1959) CHEMISTRY
FOR : ENVELOPES AND THE LIKE WITH) EXAMINING
REMOISTENABLE ADHESIVE COM-) GROUP
PRISING POLYVINYL ALCOHOL.) 140

To The Commissioner of Patents:

In response to office action and interview of October 21, 1963,
please enter the following supplemental oath.

SUPPLEMENTAL OATH

--Setrak Krikor Boyajian, the above-named petitioner, being duly sworn, deposes and says that he is a citizen of the United States of America, and a resident of Worcester, in the State of Massachusetts; that he verily believes himself to be the original, first and sole inventor of the invention described and claimed in letters patent No. 2,804,395 and in the foregoing specification and for which improvement he solicits a patent; that he does not know and does not believe that said improvement was ever known or used before his invention thereof; that applicant verily believes the original patent to be partly invalid by reason of the patentee claiming more than he had a right to claim as relates to Claims 5 and 10, and partly inoperative by reason of the patentee claiming less than he had a right to claim as relates to Claims 2-4 and 6-9 of the original patent; that the errors arose without any deceptive intention on the part of the applicant; that applicant believes said Claims 5 and 10 of the original patent to be too broad or invalid and seeks their cancellation; and that as to said Claims 2-4 and 6-9 the specification is insufficient merely because these claims are too narrow by reason of their containing unnecessary and unintentional limitations of boiling therein, and applicant seeks to obtain a limited number of additional claims directed to the same invention but merely broader in order to

express the real invention by curing the defects of the original patent. --

/s/ Setrak Krikor Boyajian
Setrak Krikor Boyajian, Applicant.

[Jurat dated October 28, 1963]

[Plaintiff's Exhibit C]

* * * U.S. DEPARTMENT OF COMMERCE * * *
Patent Office
Washington

Paper No. 49

Applicant: Boyajian, Setrak Krikor	
Ser. No. 818,990	Mailed Oct 21
Filed June 9, 1959	1963
For ENVELOPES AND THE LIKE WITH RE- MOISTENABLE AD- HESIVE COMPRISING POLYVINYL ALCOHOL	Group 140

Setrak Krikor Boyajian
Post Office Box 973
Worcester 1, Mass.

Please find below a communication
from the EXAMINER in charge of
this application.

Commissioner of Patents.

Responsive to amendments of October 14, 1963 and October 21,
1963.

1. The amendments filed October 14, 1963 and October 21, 1963 have been entered.
2. Claims 1, 2, 3, 4, 6, 7, 8, 9, 80, 82, 83, 84, 86, 87, 96, 97 and 98 are allowed.
3. Applicant has presented his U.S. Patent No. 2,804,395 for surrender.
4. This case will be passed to issue in due course.

L. J. Bercovitz: kmw

Examiner

[Plaintiff's Exhibit No. D]

[Filed December 28, 1963]

* * * A

* * *

U.S. DEPARTMENT OF COMMERCE
Patent Office
Washington

NOTICE OF ALLOWANCE

The application for patent identified below has been examined and found allowable for issuance of Letters Patent.

	Filing Date XXXXXXXXXX	Serial No. 818990	No. Claims Allowed XXXXXXXXXX	Examiner L.J. Bercovitz 14
Applicant	Boyajian, Setrak Krikor, Worcester, Mass.			MAILED NOV. 15, 1963
Assignee				
Title of Invention	Envelopes and the like with remoistenable adhesive comprising polyvinyl alcohol			117/044

- The final fee for this application has been received. The patent will be issued and forwarded in approximately two months from date.
- This application for patent was filed under the provisions of 35 U.S.C. 266 and will accordingly issue without payment of final fee.
- Since the entire interest in this invention has been assigned to the United States Government, the patent will issue without payment of final fee in accordance with the provisions of Comptroller General's Decision B-111.648 of July 13, 1953.
- The patent will be issued and forwarded in about 90 days from date unless earlier issuance, not less than two months from date, is requested by applicant.
- This application is for reissue of patent number 2,804,395.

Reissue Filing Date	No. Reissue Claims Allowed	Reissue Date
06/09/63	17	12/31/63

The patent will be reissued and forwarded on the date indicated above.

By Direction of the Commissioner.

Setrak Krikor Boyajian
Post Office Box 973
Worcester 1, Mass.

[Plaintiff's Exhibit E]

	Filing Date 06/09/59	Serial No. 818990	Patent No. RE 25504	Date of Patent 12/31/63
Inventor	Boyajian, Setrak Krikor Worcester, Mass.			
Assignee				
Invention	Envelopes and the like with remoistenable adhesive comprising polyvinyl alcohol			
Final Fee Receipt * * *	Final Fee	Date Fee Paid	Sheets of D'G 001	Class-Sub 117/044
*** * * *	Setrak Krikor Boyajian Post Office Box 973 Worcester 1, Mass.			

U.S. DEPARTMENT OF COMMERCE

PATENT OFFICE

[Plaintiff's Exhibit F]

[Mailed December 4, 1963]

[Filed, December 28, 1963]

* * * * *

1. This application has been withdrawn from issue and the prosecution has been reopened for the purpose of making the rejection to be set out hereinbelow.

2. The claims in the case are 1-4, 6-9, 80, 82-84, 86, 87 and 96-98.

3. Claims 1, 80, 84, 96, 97 and 98 are rejected as failing to comply with 35 U.S.C. 112 in omitting from the claims the statement that the polyvinyl alcohol is boiled in aqueous solution. It appears that the only basis for patentability of the claims over the art is the limitation as to the boiling of the polyvinyl alcohol in aqueous solution, which limitation appears in other claims such as claim 4. This is the position taken by both the U.S. District Court and the U.S. Court of Appeals in litigation involving applicant's Patent No. 2,804,395 of which the present case is a reissue application.

In a Memorandum Decision dated February 5, 1963 involving applicant's parent patent, the District Court Stated:

"Claims 2, 3, 4, 6, 7, 8 and 9 each expressly contains a boiling limitation, that is each claim specifically states that it includes as an "essential ingredient polyvinyl alcohol which has been boiled in aqueous solution. Claim 1 impliedly has the same limitation, according to the opinion of the Court of Appeal. 279F.2nd 572,575".

The District Court further stated:

"When this case was last here this Court stated that 'the only possible basis for contending that claim 4 shows an advance over the prior art is to rely upon the boiling of polyvinyl alcohol'. 176F.Supp.627,629".

The Court of Appeals opinion referred to by the District Court was an opinion by the Court of Appeals dated June 14, 1960 also involving applicant's Patent No. 2,804,395.

In that Opinion, the Court of Appeals stated:

"The District Court concluded that claim 1 was invalid 'because it does no more than use a series of laudatory adjectives'. It stated that: 'The claim does not describe the structure or composition of Boyajian's adhesive composition. It does not even refer to boiling the solution and held that the standards of 35 U.S.C. 112 were not met' However, if the patent was issued on the basis of boiling being implied, then there is no harm to defendant since other claims cover the invention, which is a method of obtaining such adhesive and its application to envelope seals. If the claim was allowed on its own wording we agree with the District Court that the descriptive language is functional and does not satisfy Section 112."

In view of what has been set out above, it is clear that claims which fail to expressly recite the boiling of the polyvinyl alcohol do

not define the invention in the manner required by 35 U.S.C. 112.

No reason is seen for reading the boiling step into such claims by implication when the limitation which defines the patentable advance can be explicitly set forth.

/s/ L.J. Bercovitz
Examiner

LJBercovitz: bg

[Filed February 19, 1964]

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SETRAK K. BOAJIAN, :
Plaintiff : CIVIL ACTION
v. : NO. 3088-63
EDWIN L. REYNOLDS, :
Acting Commissioner of :
Patents, :
Defendant :

MOTION TO DISMISS

Now comes the defendant, Edwin L. Reynolds, Acting Commissioner of Patents, and moves that the complaint in the above-entitled civil action be dismissed on the following grounds:

- I. The Court lacks jurisdiction over the subject matter of the complaint;
- II. The Complaint fails to state a claim against defendant upon which relief can be granted.

An oral hearing is requested.

Respectfully submitted,

/s/ C. W. Moore
Solicitor, United States Patent Office
Attorney for Defendant

February 19, 1964

Washington, D. C.
March 13, 1964

EXCERPTS FROM TRANSCRIPT OF PROCEEDINGS

Motions in the above-entitled matter came on for hearing at 10: 00 A.M.
before the Hon. Joseph R. Jackson, Judge, U.S. District Court.

* * * * *

35 MR. BOYAJIAN: One of the reasons of the complaint is to
 avoid unnecessary delay. That is what it has amounted to now. One
 of the rejected claims is from the original patent, which after having
36 been allowed for so many years is now rejected. It took four
 years or a little more than four years to get the original patent. It
 has taken almost five years more for this case. That is nine years.
 I have explained in my memorandum that a running of the time of the
 patent is not stopped; it is not affected by a reissue application. Re-
 gardless of what Mr. Moore says, it takes time to go before the Board
 of Appeals to have them summarily dismiss it. And then my only re-
 course is the Court of Customs and Patent Appeals. But why should
 all this be necessary?

I already have a patent. And I am sure I can have the Primary
Examiner, under oath, say, yes, I found those claims to be valid and
allowable and I have allowed them.

Now why should one have to go through that all over again?
Nine years to get a patent. And having to spend thousands of dollars
and many more years to defend it.

As I stated in my memorandum, all reissue applications are
special. That is true. But making it special is one thing and acting
upon it another.

I have looked at the records and usually a reissue application
takes about three years and very seldom four years. Now delay is
very important. There is a great loss.

I would move this Court to rule whether or not under Rule 131
"shall" means as has been defined in the case cited in my memorandum.

37 THE COURT: Well, that shows discretion, doesn't it?

MR. BOYAJIAN: No, it doesn't.

THE COURT: There is an exception there.

MR. BOYAJIAN: In this case there is no valid reference. There is no new reference. There is no new reference whatsoever.

Don't you see, Your Honor, it is a clear case of whether or not U.S. Code Title 35, 131 means that when the application has been found allowable and allowed "shall" means that the Commissioner of Patents shall issue the patent.

It is not a matter of discretion. So the remedy you speak of is not really a remedy for me. As I say, it will take from two to five years more.

THE COURT: I think the Court thoroughly understands your contention.

* * * * *

38 MR. MOORE: . . .

I would deny (dismiss), without specifically mentioning, the allegations that the plaintiff has made in his arguments.

THE COURT: Well, I think the Court understands it very well.

MR. BOYAJIAN: May I say another word, Your Honor?

THE COURT: No, I have heard plenty. I have been very patient
39 listening. There is a law that is completely established here in that Moore Case, where mandamus cannot be substituted for the remedy afforded by appeal. I am reading from it: "Neither can it be invoked for the purpose of reviewing or controlling the action of the Commissioner in refusing to issue relator a patent." Now that is the law. It may seem harsh. Of course, the losing party always feels things are harsh. But, nevertheless, under the established law of this Circuit, the Court will deny your petition for mandamus and grant the motion in toto to dismiss.

[Filed March 16, 1964]

ORDER

This action came on to be heard at this term on motion of defendant, Edwin L. Reynolds, Acting Commissioner of Patents, to dismiss the complaint and thereupon, upon consideration thereof, it is this 16th day of March, 1964,

ORDERED that the motion to dismiss be and it is hereby granted, and that the complaint be and it is hereby dismissed.

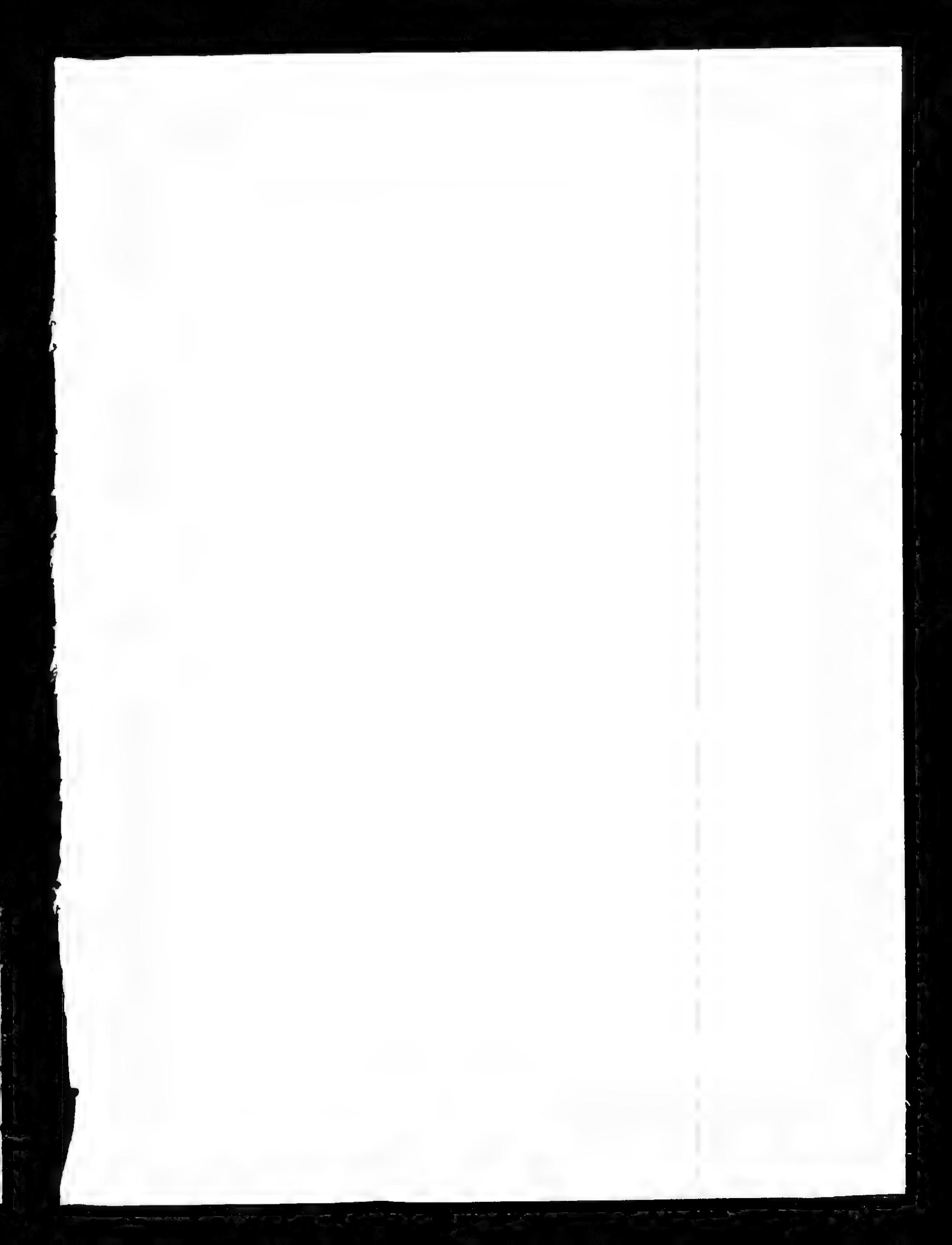
/s/ Joseph R. Jackson
JUDGE

[Filed May 15, 1964]

NOTICE OF APPEAL

Notice is hereby given this 15th day of May, 1964, that Setrak K. Boyajian, plaintiff above named, hereby appeals to the United States Court of Appeals for the District of Columbia from the judgment of this Court entered on the 16th day of March, 1964 in favor of above-named defendant against said plaintiff.

/s/ Setrak K. Boyajian
SETRAK K. BOYAJIAN,
Plaintiff



BRIEF FOR APPELLEE

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 18,717

SETRAK K. BOYAJIAN, APPELLANT

v.

EDWIN L. REYNOLDS, Acting Commissioner of
Patents, APPELLEE

Appeal From The United States District Court
For The District of Columbia

CLARENCE W. MOORE,
Solicitor, United States Patent Office,
Attorney for Appellee.

United States Court of Appeals
for the District of Columbia Circuit

FILED 10-16-1964

Nathan J. Paulson
CLERK

Appeal No. 18,717

STATEMENT OF QUESTION PRESENTED

In the opinion of appellee, the single question presented by this appeal is:

Did the District Court err in dismissing, upon motion of appellee, a complaint in which appellant sought an order in the nature of a mandamus to compel appellee to issue him a reissue patent on his rejected application for a reissue patent and also to prescribe the circumstances under which access to the reissue application could be given by appellee and protests against the grant of a reissue patent thereon, received?

INDEX

	Page
Statement Of Question Presented	Prefixed
Introduction.....	1
Counterstatement Of The Case.....	2
Summary of Argument.....	6
Argument.....	7
Conclusion.....	14
 Authorities Cited:	
Cases:	
Anderson v. Watson, 103 U.S. App. D.C. 99, 254 F.2d 956.....	7
Boyajian v. Old Colony Envelope Co., Inc., 139 USPQ 249, 323 F.2d 871, cert. denied, April 6, 1964, 376 U.S. 969, rehearing denied May 18, 1964, — U.S. —.....	5
Ewing, Commissioner of Patents v. United States ex rel. Fowler Car Company, 244 U.S. 1.....	7
Kingsland v. Carter Carburetor Corporation, 83 U.S. App. D.C. 266, 168 F.2d 565.....	10
Moore, Ex parte, 1927 C.D. 87.....	13
<u>Moore v. United States ex rel. Chott, 40 App.</u> <u>D.C. 591, writ of error dismissed, 237 U.S. 197..</u>	<u>6, 7</u>
Old Colony Envelope Co., Inc. v. Boyajian, 139 USPQ 265, 223 F.Supp. 905.....	5
United States ex rel. Dunkley Company v. Ewing, 42 App. D.C. 176	6, 10
United States ex rel. Dwiggins v. Ewing, 43 App. D.C. 204, cert. denied, 238 U.S. 640.....	7, 10
 Rules:	
Rule 291 of the Rules of Practice of the United States Patent Office in Patent Cases, 37 C.F.R. 1.291.....	7, 13
Rule 313 of the Rules of Practice of the United States Patent Office in Patent Cases, 37 C.F.R. 1.313.....	8

Statutes:	Page
35 U.S.C. 6.....	7
35 U.S.C. 102.....	9
35 U.S.C. 103	9
35 U.S.C. 112.....	9
35 U.S.C. 122.....	6, 13
35 U.S.C. 131.....	7, 11
35 U.S.C. 134.....	6, 10
35 U.S.C. 141.....	6, 10
35 U.S.C. 145.....	6, 10
35 U.S.C. 251.....	7
Section 4893 R.S.....	11

**United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT**

Appeal No. 18,717

SETRAK K. BOYAJIAN, APPELLANT

v.

**EDWIN L. REYNOLDS, Acting Commissioner of
Patents, APPELLEE**

**Appeal From The United States District Court
For The District of Columbia**

BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

This is an appeal from an Order (J.A. 22) of the United States District Court for the District of Columbia, dismissing, upon a motion by appellee (J.A. 19), a complaint (J.A. 2) in which appellant prayed (J.A. 9):

I. That a writ of mandamus be issued directing and commanding appellee forthwith to return appellant's application for reissue of his

(1)

patent "to the Issue Branch of the United States Patent Office and direct and cause the issuance of the reissue patent in due course and without any further interference therein."

II. That a writ of mandamus be issued directing and commanding appellee "to keep the said reissue application in confidence while it is pending in the Patent Office and not to give out information concerning the same without authority in writing from * * * petitioner [appellant] as provided by 35 U.S.C. 122; nor to permit the outside interference with the ex parte prosecution of said reissue application."

COUNTERSTATEMENT OF THE CASE

The Statement of the Case set forth in the Brief for Appellant (pages 2 to 7) includes so many allegations (page 3, antepenultimate and penultimate paragraphs; page 4, first, third, fourth, fifth, sixth, and seventh paragraphs; page 5, first, second and third paragraphs; and page 6, first and second paragraphs) dehors the record, which is to say, dehors the complaint, motion to dismiss, and attached exhibits, that a Counterstatement seems to be in order. The salient facts are simple and few and are recited in the following two paragraphs.

Pending in the Patent Office, before the Primary Examiner, is appellant's reissue application, Serial No. 818,990, filed June 9, 1959 (J.A. 2, Complaint, paragraphs 6 and 10), for reissue of his patent No. 2,804,395, granted August 27, 1957 (*ibid.*, paragraph 5; J.A. 10 to 13, "Plaintiff's Exhibit A"). By a letter mailed October 21, 1963 (J.A. 15, "Plaintiff's Ex-

hibit C"), the Examiner notified appellant of the allowance of all the claims of said reissue application and stated: "This case will be passed to issue in due course." On November 15, 1963, a formal notice of allowance was sent to appellant (J.A. 16, "Plaintiff's Exhibit D"), and, shortly thereafter, appellant additionally was notified by the Patent Office (J.A. 17, "Plaintiff's Exhibit E") of the number of his expected reissue patent (J.A. 2, Complaint, paragraph 11). However, the reissue patent was not issued, as scheduled. Instead, the reissue application was withdrawn from issue, its prosecution was reopened, and a further rejection of six claims thereof, claims 1, 80, 84, 96, 97, and 98, was entered. That rejection (J.A. 17, "Plaintiff's Exhibit F") reads, as follows:

Claims 1, 80, 84, 96, 97 and 98 are rejected as failing to comply with 35 U.S.C. 112 in omitting from the claims the statement that the polyvinyl alcohol is boiled in aqueous solution. It appears that the only basis for patentability of the claims over the art is the limitation as to the boiling of the polyvinyl alcohol in aqueous solution, which limitation appears in other claims such as claim 4. This is the position taken by both the U.S. District Court and the U.S. Court of Appeals in litigation involving applicant's Patent No. 2,804,-395 of which the present case is a reissue application.

In a Memorandum Decision dated February 5, 1963 involving applicant's parent patent, the District Court Stated:

"Claims 2, 3, 4, 6, 7, 8 and 9 each expressly contains a boiling limitation, that is

each claim specifically states that it includes as an "essential ingredient polyvinyl alcohol which has been boiled in aqueous solution. Claim 1 impliedly has the same limitation, according to the opinion of the Court of Appeal. 279F.2nd 572,575".

The District Court further stated:

"When this case was last here this Court stated that 'the only possible basis for contending that claim 4 shows an advance over the prior art is to rely upon the boiling of polyvinyl alcohol'. 176F.Supp.627,629".

The Court of Appeals opinion referred to by the District Court was an opinion by the Court of Appeals dated June 14, 1960 also involving applicant's Patent No. 2,804,395.

In that Opinion, the Court of Appeals stated:

"The District Court concluded that claim 1 was invalid 'because it does no more than use a series of laudatory adjectives'. It stated that: 'The claim does not describe the structure or composition of Boyajian's adhesive composition. It does not even refer to boiling the solution and held that the standards of 35 U.S.C. 112 were not met' . . . However, if the patent was issued on the basis of boiling being implied, then there is no harm to defendant since other claims cover the invention, which is a method of obtaining such adhesive and its application to envelope seals. If the claim was allowed on its own wording we agree with the District Court that the descriptive lan-

guage is functional and does not satisfy Section 112."

In view of what has been set out above, it is clear that claims which fail to expressly recite the boiling of the polyvinyl alcohol do not define the invention in the manner required by 35 U.S.C. 112.

No reason is seen for reading the boiling step into such claims by implication when the limitation which defines the patentable advance can be explicitly set forth.

The "Memorandum Decision," referred to by the Examiner, is that of District Judge Wyzanski of the United States District Court for the District of Massachusetts in *Old Colony Envelope Co., Inc., v. Boyajian*, 139 USPQ 265, 223 F.Supp. 905. His amended judgment was affirmed by the United States Court of Appeals for the First Circuit in *Boyajian v. Old Colony Envelope Co., Inc.*, 139 USPQ 249, 323 F.2d 871, cert. den. April 6, 1964, 376 U.S. 969, rehearing den. May 18, 1964, — U.S. —. Appellee on December 12, 1963, denied (J.A. 8, Complaint, paragraphs "22") a petition by appellant that his re-issue application "be returned to the Issue Branch of the Patent Office for issue in due course."

"The attorney for the accused infringers" in the court case reported, as above, and additionally at 123 USPQ 337; 176 F.Supp. 627, 125 USPQ 603; 279 F.2d 572, and 140 USPQ 215; 223 F.Supp. 905, appellant charges in his complaint (J.A. 6, paragraph 15), "was unlawfully permitted, unbeknown to * * * petitioner [appellant], to prosecute a case against

granting the reissue patent, by the * * * Deputy Solicitor of the Patent Office acting in the name of the Commissioner." Appellant expresses the belief (*ibid.*, paragraph 16) that "his * * * allowed reissue application was withdrawn at the instigation and on behest of * * * attorney for the accused infringers."

SUMMARY OF ARGUMENT

Granting of appellee's motion to dismiss, and consequent denial to appellant of an order in the nature of a writ of mandamus to compel appellee to issue a reissue patent upon appellant's application for a reissue patent, containing rejected claims 1, 80, 84, 96, 97, and 98 of said application, was in order under such a decision as the decision of this Court in *Moore v. United States ex rel. Chott*, 40 App. D.C. 591, holding that mandamus cannot be invoked for the purpose of reviewing or controlling the action of the Commissioner of Patents, in the exercise of his supervisory authority, in refusing a patent. There are no distinctions of significance between that case and the case at bar. The rejection is open to review before the Board of Appeals in the Patent Office under 35 U.S.C. 134 and to judicial review under 35 U.S.C. 141 or 145. No court is privileged, in advance, to pass upon the rejection, entered in the exercise of their jurisdiction by the Commissioner and the Examiner. *United States ex rel. Dunkley Company v. Ewing*, 42 App. D.C. 176.

The matter of keeping appellant's reissue application in confidence is entrusted, by 35 U.S.C. 122, to

the Commissioner and not to the courts. Also, it is for the Commissioner to determine, under Rule 291, what protests he will receive.

ARGUMENT

The decision of this Court in *Moore v. United States ex rel. Chott*, 40 App. D.C. 591, writ of error dismissed, 237 U.S. 197, upon which the District Court particularly relied and from which that Court quoted (J.A. 21, final paragraph), establishes, as a general rule of law, that mandamus cannot "be invoked for the purpose of reviewing or controlling the action of the Commissioner in refusing to issue [a] relator a patent." Other decisions by this Court to the effect that the broad supervisory authority respecting the granting and issuing of patents, conferred on the Commissioner of Patents by 35 U.S.C. 6, and the broad discretionary powers in the examination of applications for patents including applications for reissue of patents (see 35 U.S.C. 251, third paragraph), conferred on the Commissioner by 35 U.S.C. 131, are not to be controlled or regulated by mandamus or injunction, include *United States ex rel. Dwiggins v. Ewing*, 43 App. D.C. 204, cert. denied, 238 U.S. 640; *Ewing, Commissioner of Patents v. United States ex rel. Fowler Car Company*, 244 U.S. 1, and *Anderson v. Watson*, 103 U.S. App. D.C. 99, 254 F.2d 956. The rule established by the *Moore* case, and confirmed by the others, applies fully to the case at bar, as the learned District Judge found (J.A. 21, final paragraph). In the *Moore* case, as here, the broad question (see third paragraph of

opinion) comes to whether the decision of another tribunal of the Patent Office "was binding upon the Commissioner to the extent that nothing remained for him to do except to perform the mere ministerial act of issuing the patent." That question was answered, adversely to Chott, in the *Moore* case, for reasons fully given; and stands answered adversely to appellant.

The distinctions appellant would draw between the decided case and the case at bar (Brief for Appellant, page 11, first paragraph) either go to insignificant details or arise from the color appellant gives his contentions. In the *Moore* case, there was, of course, no allowance of the claims by the Primary Examiner; the claims, instead, were allowed by a higher tribunal, the Board of Examiners-in-Chief. And there was no notice of allowance and no notification of patent number, for the reason that the Commissioner exercised his supervisory authority before the Chott application reached those stages. The withdrawal of appellant's reissue application from issue was not "arbitrary." It was in compliance with Rule 313 of the "Rules of Practice of the United States Patent Office in Patent Cases," 37 C.F.R. 1.313 (see Appendices to Appellant's Brief, Appendix K, page 5a), which makes specific provision for withdrawal from issue to correct a "mistake on the part of the Office." Such withdrawal may, under Rule 313, occur at any time prior to the delivery of the Letters Patent. The withdrawal, moreover, was predicated upon the court opinion quoted in the rejection of claims of appellant's reissue application entered by the Examiner

(J.A. 17 to 19); and the quoted opinion demonstrates that the rejection is not arbitrary. In this connection, it is to be noted that claim 1 of appellant's patent, referred to in the court's opinion as quoted, is necessarily the same as claim 1 of appellant's reissue application, rejected by the Examiner. For appellant to imply that his reissue application was withdrawn from issue without "giving", which is to say, citing, "any new reasons" is for appellant to ignore his allegations in paragraph 14 of his complaint (J.A. 5), which merely are to the effect that the reasons for withdrawal must earlier have been known to the Examiner. No citation of references was in order, for the Examiner's rejection expressly is based upon 35 U.S.C. 112, and not upon 35 U.S.C. 102 or 103. What purpose "advance notice to applicant" of withdrawal would have served is not spelled out by appellant, and is not apparent. And a simple reliance on a court opinion of manifest relevancy as a basis for rejection can not be given a sinister aspect, by reason of a smear insinuation of "secret cooperation with accused infringers on the part of the Patent Office."

Appellant's oblique attack (Brief for Appellant, page 11, final paragraph, to page 13, line 4) on the supervisory authority of the Commissioner of Patents has all the aspects of an exercise in futility in view of appellant's disclaimer of saying anything which "should be construed as a claim by appellant * * * that the power of the Commissioner has been curtailed in any way since the *Moore* case was decided." The rule of the *Moore* case fits the facts

and applies to the case at bar. The sweep of the Commissioner's supervisory authority continues to be recognized by this Court as in *Kingsland v. Carter Carburetor Corporation*, 83 U.S. App. D.C. 266, 168 F.2d 565. And two instances of resort by appellant to such authority in seeking relief are indicated, (1) by his complaint (paragraphs 21 and 22, J.A. 7 and 8), and (2) by his brief (pages 5 and 6; third paragraph, page 5, and quotation continuing to page 6).

The question whether or not appellant is entitled to a reissue patent containing claims 1, 80, 84, 96, 97 and 98 of his reissue application, rejected therein by the Examiner (J.A. 17 to 19), plainly is cognizable by the Patent Office Board of Appeals, on appeal by appellant under 35 U.S.C. 134, and likewise cognizable by the United States Court of Customs and Patent Appeals, on an appeal under 35 U.S.C. 141, and the United States District Court for the District of Columbia, in case of alternative review by civil action under 35 U.S.C. 145, and any error that the Examiner may make in the determination of that question accordingly is subject to correction by those tribunals. Jurisdiction in the Commissioner, and hence in his subordinate, the Examiner, to consider the question, is fixed by the rule of the *Moore* case (see also *United States ex rel. Dwiggins v. Ewing*, 43 App. D.C. 204, cert. denied, 238 U.S. 640). What was said by this Court in *United States ex rel. Dunkley Company v. Ewing*, 42 App. D.C. 176, therefore may be paraphrased, as follows, to apply to the case at bar: The Commissioner and the Examiner having jurisdiction, and a plain and adequate remedy under

35 U.S.C. 134 and 35 U.S.C. 141 or 145 being open to appellant, this Court is not at liberty to determine in advance, through mandamus proceedings, in what manner the Commissioner and the Examiner shall exercise their jurisdiction.

The construction appellant seeks (Brief for Appellant, pages 14 and 15, paragraphs 5 and 6) of the verb "shall" in such a section of the patent statute as 35 U.S.C. 131 has, in effect, already been refused by this Court in the *Moore* case. In the *Moore* case, this Court considered Section 4893 of the Revised Statutes. It read:

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

In the present patent statute, the corresponding section, 35 U.S.C. 131, reads:

Examination of application. The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

There is no substantial difference between the copied sections. Concerning Sec. 4893 R.S., this Court, in the *Moore* case, said:

It will be observed that nothing appears in the act conferring jurisdiction upon the Board of Examiners-in-Chief in any way depriving the Commissioner of the general power conferred upon him by law to satisfy himself before issuing a patent—

that the claimant is justly entitled to a patent under the law.

Unquestionably, the decision of the Board of Examiners-in-Chief, when favorable to the claimant, is final, unless the Commissioner, in the exercise of his general supervisory power, has authority, upon his own independent investigation, to determine finally whether a patent shall issue. The same would be true of a decision by the Primary Examiner in favor of an applicant. When an application is made for a patent, it is the duty of the Commissioner to cause an examination to be made, and—

if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

The examination here required to be made may or may not lead to an appeal to the Board of Examiners-in-Chief, but whether it does or not, in order to determine that a patent should issue, when it ultimately comes back to the Commissioner after the examination ordered under the statute has been made, he may, upon inspection and review of the examination made pursuant to his order, find that the alleged invention is neither novel nor meritorious. In such a case he

would not be bound to violate his official obligation. There is nothing in the law to prevent him from exercising this supervision.

Appellant is not entitled to the relief requested by him in prayer II (J.A. 9) of his complaint, which is the issuance of a writ of mandamus directing and commanding appellee "to keep the * * * reissue application in confidence * * * and not to give out information concerning the same without authority in writing" from appellant, and to permit no "outside interference with the ex parte prosecution of said reissue application." The statute, 35 U.S.C. 122, vests the Commissioner of Patents, and not the District Court, with discretion in determining under what "special circumstances" information may be given concerning an application for patent. It is for the Commissioner to determine whether an accused infringer involved in a suit on a patent might be entitled to access to an application for reissue of that patent. See *Ex parte Moore*, 1927 C.D. 87. Likewise, under Rule 291 of the "Rules of Practice of the United States Patent Office in Patent Cases," 37 C.F.R. 1.291 (Appendices to Appellant's Brief, page 4a, Appendix H), it is for the Commissioner to determine what use shall be made of the information contained in a protest against the grant of a patent, if such a protest be supposed to be "outside interference with the ex parte prosecution" of an application for patent.

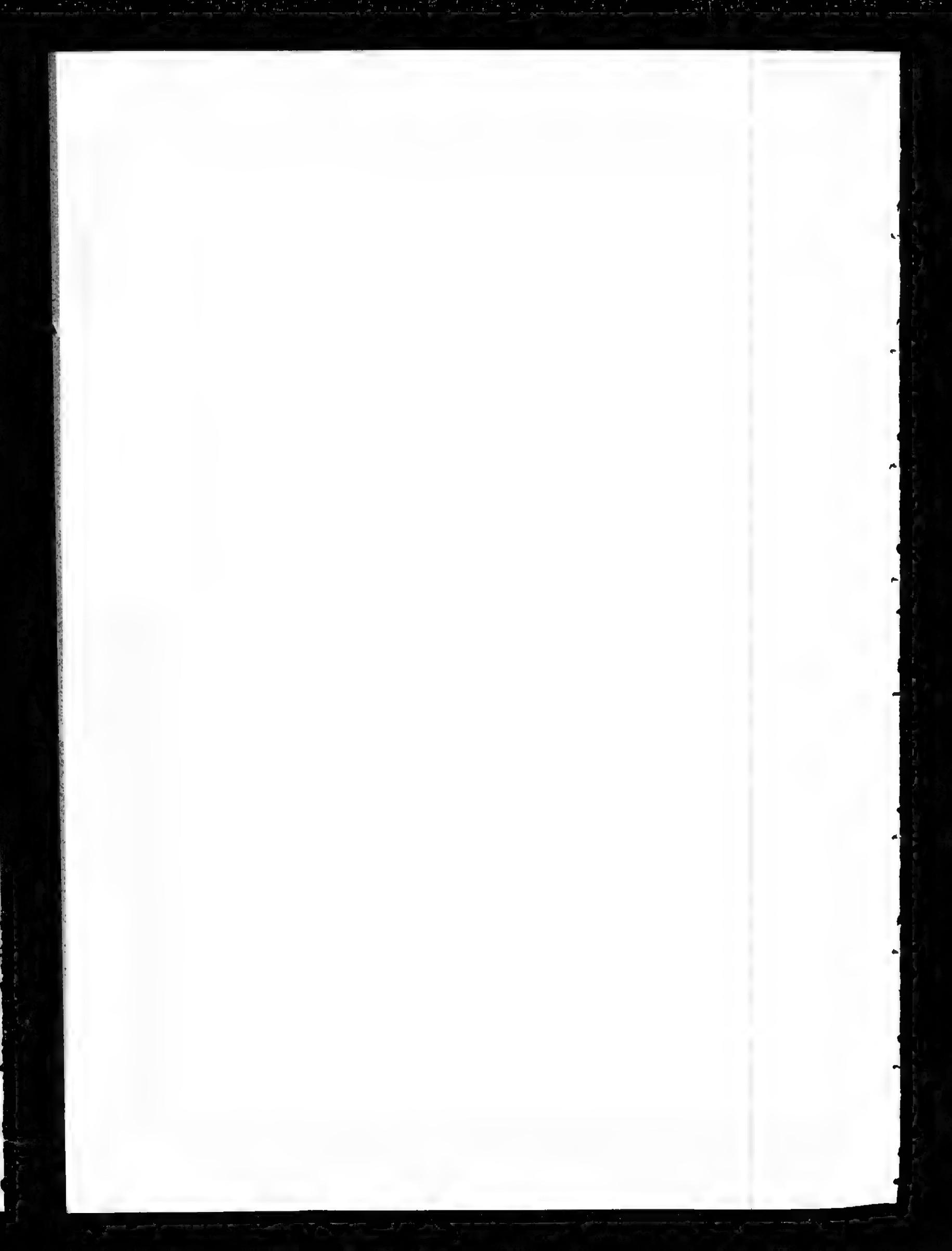
CONCLUSION

It is submitted that the District Court was correct in dismissing appellant's complaint. Affirmance of its order accordingly is requested.

Respectfully submitted,

CLARENCE W. MOORE,
Solicitor, United States Patent Office,
Attorney for Appellee.

September, 1964



REPLY BRIEF FOR APPELLANT

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,717

SETRAK K. BOYAJIAN,

Appellant,

v.

**EDWIN L. REYNOLDS,
Acting Commissioner of Patents,**

Appellee.

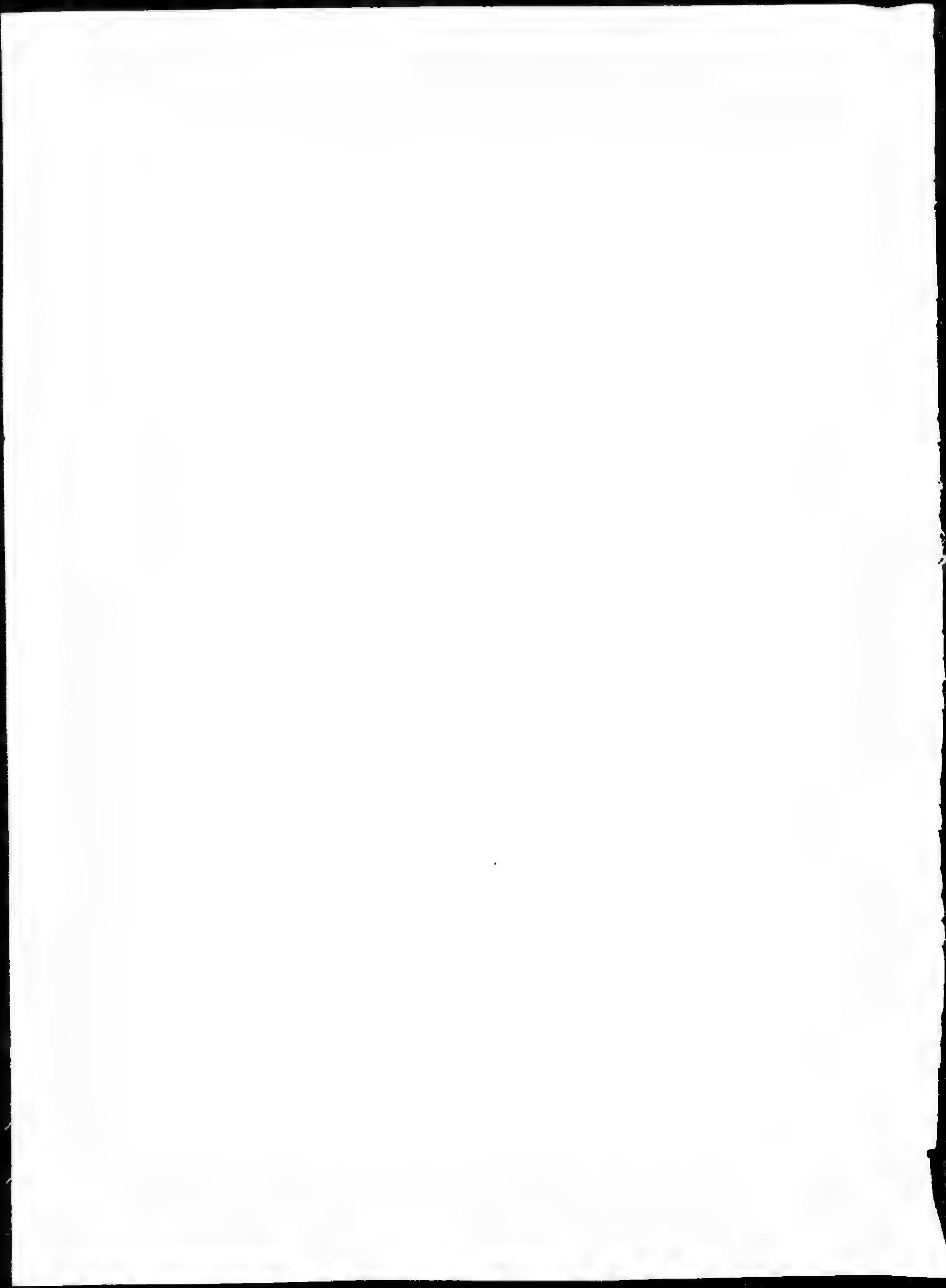
Appeal from the United States District Court
for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED : 1964

J. Wilson

**SETRAK K. BOYAJIAN,
Appellant.**
P. O. Box 973,
Worcester, Massachusetts,
01601



United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,717

SETRAK K. BOAJIAN,

Appellant,

v.

**EDWIN L. REYNOLDS,
Acting Commissioner of Patents,**

Appellee.

Appeal from the United States District Court
for the District of Columbia

REPLY BRIEF FOR APPELLANT

Appellee begins his brief with obvious misstatements of the facts and issues of the case in the very "Statement of Question Presented", basing his arguments throughout said brief on similar misstatements. Pertinent facts of the case are stated in the complaint (J.A. 2-9). If appellee was not willing to accept such facts as true, he was at liberty to

file an answer and attempt to disprove them by proceeding on the merits. Instead he filed a motion to dismiss thereby admitting the truth of such facts, and he must now abide by his admissions.

The words "rejected application" in the third and fourth lines of appellee's said "Statement of Question Presented" are directly in contradiction with the documentarily proven facts (see Notice of Allowance, J.A. 16; see also J.A. 4-5), and appellee knows it to be so. He also knows that appellant only seeks the grant of the reissue patent on his ALLOWED APPLICATION under 35 U.S.C. 131. As to prescribing "the circumstances under which the access to the reissue application can be given by appellee", Congress has already done so (Appendix C), and any excess on the part of appellee in the administration of such prescription is subject to judicial action under 5 U.S.C. 1009. Nor is there any statutory foundation, or any justification (except in public use proceedings under Rule 292, Rules of Practice of the United States Patent Office) for receiving "protests against the grant of a reissue patent". Nor is there any provision for (as there is against) organized opposition in Rule 291, Rules of Practice of the United States Patent Office (Appendix H). Appellee has in this case afforded the accused infringers organized opposition secretly to the grant of appellant's reissue patent, in violation of all patent laws, rules, and procedure.

In view of the foregoing facts it is obvious that appellee's "statement of question presented" is not germane to this case and has no status therein. Appellant's "Statement of Questions Presented", on pages (i) and (ii) of his brief fully sets forth the material issues of fact and law, and appellant respectfully requests this Honorable Court for a ruling thereon.

Or, in the alternative, at the Court's pleasure, the questions presented in appellant's said statement may be certified to the Supreme Court of the United States for a ruling thereon before the disposition of the case in this Court.

On the second page of his brief, in his purported "Statement of the Case", which is really an argument, Appellee makes a good display of bad dictionary, pretending that what appellant has said in certain paragraphs on pages 2 to 7 of his main brief contradicts his own pleadings. Nothing could be farther from the truth. All that has been said in said pages 2 to 7, taken together, lends ample support to the fact that from the very beginning an unlawful interference with appellant's ex parte prosecution of his application was permitted by the Patent Office, and that the repeated rejections of the claims in the original patent were the results thereof. Commissioner Ladd sensed that there was something wrong in the examination of appellant's application. The rest is in the record.

In the 12th and 13th lines of the third page of appellee's brief the statement "and a *further* rejection of six claims thereof, was entered" is an obvious error since the rejection was that of claims from the allowed application.

Next, on pages 3 to 5 of his brief, appellee quotes from the December 4, 1963, office letter of the Primary Examiner rejecting the said six allowed claims (Plaintiff's Exhibit F -- J.A. 17-18) with quotations from the appellate and district court decisions involving the original patent (Plaintiff's Exhibit A -- J.A. 11-12-13) as reasons for rejecting the said allowed claims. It must again be noted that these decisions were made on June 14, 1960, and on February 5, 1963, respectively, or more than two years and four months in the first case and more than eight months in the second case before the date (October 21, 1963) on which the seventeen claims of the reissue application were allowed, and that the case was not sent to the Issue Branch of the Patent Office until sometime in the middle of November, 1963. As already stated, these decisions were promptly submitted and filed in the reissue application, and both the Primary Examiner and Deputy Solicitor had these decisions before them, and they were in their full possession in all that time.

Why then after all that time all of a sudden such decisions assumed the aspect of such forceful references in the case as to compell its withdrawal from issue on said December 4, 1963? It appears that the machination of such withdrawal started on an earlier date (on November 27, 1963, to be exact) by a round robin paper (Defendant's Exhibit Y -- heretofore unprinted) entitled "Withdrawal from Issue", reading as follows:

"It is requested that the above-entitled application be withdrawn from issue for the purpose of rejecting claims 1, 80, 84, 96 and 98 in view of the decision of the U.S. Court of Appeals for the First Circuit based on a Memorandum decision of the U. S. District Court, District of Massachusetts."

During the hearing on defendant's motion to dismiss the District Court asked (page 4, transcript of hearing) in reference to said paper:

THE COURT: "Who drafted it? Whose brain child is it?"

MR. MOORE: "It is from the Examiner, Your Honor."

THE COURT: "The Examiner who had examined the Application?"

MR. MOORE: "The Examiner who had examined the application and the Examiner who had signed the allowance."

THE COURT: "And then he withdrew his allowance, is that it?"

MR. MOORE: "He requested the application to be withdrawn from issue"

Plaintiff (appellant herein) answered the foregoing representations by defendant (appellee herein) during the said hearing, as follows:

(Page 20)

MR. BOYAJIAN:

"The reasons stated in the December 4th action were not sufficient to withhold the issue of the patent, nor would they be sufficient to reject any of the claims; aside from (Page 21) the fact that the Examiner already had all the information before he had allowed the claims. He had all this information and more before him.

"So when I received the December 4 action I called up the Primary Examiner and said: 'What is the story?' He said: 'I was only obeying orders.' I said: 'Did you think those claims were allowable when you sent the application to issue?' He said: 'Yes.' Do you still think so?' And he said: 'Yes'.

"That was on Friday. On Monday I came to Washington and had an interview with the Primary Examiner and another interview with the (Acting) Commissioner.

"The (Acting) Commissioner said: 'Well, Mr. Schimmel told me about it.' And when I asked the Primary Examiner he said: 'It was Mr. Schimmel or Mr. Reynolds, or Mr. Schimmel acting for him.' He said it was not his doing.

"The circumstances are so clear as to what happened that they (it) could not be (have been) any way other than as follows:

"The attorney for the plaintiffs in the court cases had used pressure on Mr. Schimmel and Mr. Schimmel had exerted pressure, in turn, to have the request for withdrawal signed by the Primary Examiner, by the Supervisory Examiner and by the Director of Examining Procedure (Director of Chemical Examining Operation).

"On the face it looks as if the request for the (page 22) withdrawal had come from these three individuals. I (again) asked the Primary Examiner: 'What did you withdraw it (application) for?' He said: 'I had no reason to withdraw it; I allowed these claims; I know they are all right.'

"And he said: 'That is why I sent the case to issue.' He further said: 'Not only was Mr. Schimmel in on it every step of the way in the allowance of these claims, but also my Supervisory Examiner was consulted at every step.'

* * * * *

(Page 25)

"It was not the intent of Congress that questions of (page 26) patentability should be determined not by the Patent Office but by accused infringers, who would tell the Patent Office what claims are allowable and what claims are not allowable. That is just what happened in this case.

". . . , the Deputy Solicitor was induced by pressure, by representations, or what have you, to have the application withdrawn from issue. And that wasn't exactly what Congress had intended when it vested power in the Commissioner under 35 U.S.C. 6."

Appellee's somewhat extensive quotation from the decision in the summary judgment proceedings involving the original patent is not quite extensive enough to tell all the story upon the relevance of such decision on the issues before this Court. It must be remembered that the merits of the invention are not in issue here. As already stated, such merits were settled by the Patent Office when it allowed the application and sent it to issue "by direction of the Commissioner" (J.A. 16). Even if it were otherwise, the reasons stated are not valid reasons for the rejection. Going back to appellant's (plaintiff below) statement in the transcript of hearing before the District Court:

MR. BOYAJIAN: . . .

(Page 22)

"In his action of December 4th the Primary Examiner states reasons which are not valid reasons for the withdrawal. For instance, here is one of the reasons: Judge Wyzanski had said that claims 2, 3, 4, 6, 7, 8 and 9 each expressly contains a boiling limitation, that is each claim specifically states that it includes as an essential ingredient polyvinyl alcohol which has been boiled in aqueous solution. He further said, claim 1 impliedly has the same limitation. The Court found all of these claims presumably valid subject to a trial on the merits.

"Then the said action of December 4 states: 'In view of 35 U.S.C. 112 the claims which fail to expressly recite the boiling of the polyvinyl alcohol do not define the invention.'

"To Section 112, Your Honor, a new paragraph was added in 1952, paragraph 3. Let me see if I can find that (Page 23) (Reading) "An element in a claim . . . may be expressed as a means or step for performing the specified function without the recital of structure, material or act in support thereof, and such claim shall be construed to cover the corresponding structure, material, or act described in the specification and equivalents thereof. (See Appendix F)

"So that the fact that the District Court had read the boiling step into claim 1, which does not contain such step, does not invalidate the claim in any sense whatsoever, because it says here that such claims shall be construed to cover the corresponding, etc. But the claim is valid.

"Now, one court may say (it) one way and another court another way, but the claim must be there in order to defend it against an infringer.

"It has been decided by the Supreme Court in a number of cases that one cannot — I am going to read the case of *Deering v. Winona Harvester Works*, 155 U.S. 286 (see J.A. 4):

* * * * *

(Page 24)

"'Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise element described in the patent as rendering it operative must be read into the claim.'

* * * * *

(Page 25)

"Now, this is a well established law and it was restated in *Charles Hanson v. Ottis M. Colliver and Floyd E. Fuller*, 282 F.2d 66, Court of Appeals, 9th Circuit, wherein it was held that:

"'It is a well established rule of construction that a broad claim will not be construed to contain limitations expressed in more narrow claims.' And it cited *Smith v. Snow*, 1935, 294 U.S. 1, and other cases.

"There are other decisions along that line. When one files a reissue application it is to correct errors in the patent and not to get the same patent back, because he already has that. Its purpose in this case is to add claims that are supported by the specification. There are no allegations that rejected claims are not supported by the specification.

(Page 28)

"Now, 35 U.S.C. 131 reads:

(Page 29)

(Reading) "'Examination of application — The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such

examination it appears that the applicant is entitled to a patent under the law, the Commissioner *shall* issue a patent therefor.' (Emphases added) (See Appendix D)

"According to what Mr. Moore (has) said with respect to Section 6 of 35 U.S.C., the (word) '*shall*' (in Section 131) doesn't mean '*shall*' but it means just 'may' or 'will' or 'if you please'. (Emphases added.)

"Now, the word '*shall*' is used, and I have given citations with respect to what the word '*shall*' means in the statutes. It doesn't leave any room for discretion. (Emphases added)

"Because of an outsider, who is an (accused) infringer, who has no new references to offer, and only because it would please him if the application is withdrawn, the application was so withdrawn. Is that a proper procedure? Is that a proper conduct on the part of the Patent Office as an exalted branch of the Government? Under both the rules and the statute it is not.

"The examination or prosecution of an application is *ex parte*. No organized opposition is supposed to be permitted. In this case it has been permitted.

"The withdrawal from issue of the patent application was on account of that outside intervention and not because the (Page 30) Examiner believed he had made a mistake. Now, here is a case where(in) there is no ground for rejection whatsoever. The Court below (Mass.) said that the claims were valid, or, at least, 'presumably valid'."

Referring once more to the decision of Judge Wyzanski (cited on page 5 of appellee's brief), that decision was based on an order entered by him back on September 10, 1962. That order reads, in part as follows:

"2. With respect to 'plaintiffs' motion for 'settlement of procedure for hearing of plaintiffs' motion for summary judgment' the Court rules:

a. The Court interprets the opinion and judgment of the Court of Appeals as authorizing this Court finally to adjudicate claims 5 and 10 as invalid. * * * * *
The Court will continue to hear so much of the case as involves claims 1, 2, 3, 4, 6, 7, 8, and 9."

Judge Wyzanski's "Amended Judgment" of February 6, 1963, reads in part as follows:

"It is ORDERED, ADJUDGED, and DECREED that

"1. Claims 5 and 10 of Boyajian U.S. Patent No. 2,804,395 are declared invalid.

"2. Plaintiffs have not infringed claims 1, 2, 3, 4, 6, 7, 8, and 9 of Boyajian U.S. Patent No. 2,804,395."

It will be noted from the foregoing order and judgment that nothing said therein indicates any invalidity of the eight claims named. As a condition of prompt allowance of his application, appellant cancelled said claims 5 and 10. It will also be noted that the said allowance did not take place until more than one year after the said order of September 10, 1962, and not until after the Primary Examiner and the Deputy Solicitor (to name just two) had been fully satisfied that appellant was entitled to his reissue patent. As a matter of fact, the said Deputy Solicitor (Schimmel) took an important part in drafting appellant's Supplemental Oath (Plaintiff's Exhibit B — J.A. 14), particularly as it relates to the following portion thereof, reading:

"* * *; and that as to said claims 2-4 and 6-9 the specification is insufficient merely because these claims are too narrow by reason of their containing unnecessary and unintentional limitations of boiling therein, and applicant seeks to obtain a limited number of additional claims directed to the same invention but merely broader in order to express the real invention by curing the defects of the original patent."

Needless to say that appellant promptly submitted and filed in the case said order of September 10, 1962, as he has so submitted all other court proceedings on the original patent. If material, it could be noted here that the judgment of non-infringement in the said court case was solely predicated upon an affidavit by the accused infringers that they are "not boiling" — without any trial.

That which has been above set forth makes it clear that all the purported reasons for the withdrawal and rejection stated in said office

action of December 4, 1963 (Plaintiff's Exhibit F — J.A. 17-19) are feigned, and are not valid reasons.

In his effort to prove unlimited discretionary power, appellee has cited in his brief five cases in addition to the *Moore* case (40 App. D.C. 591) which has already been fully discussed. (See pages 9, 10, 11 and 13 of appellant's main brief).

All of the said five cases relate to proceedings in interference cases, dealing with circumstances which are not in any way comparable to the circumstances of this case, nor do they contain any ruling which may be deemed in any way as controlling herein. Taking these cases in their chronological order, they are herein summarized as follows:

In *United States Ex Rel. Dunkley Company v. Ewing* (1914), 42 App. D.C. 156, the Court said:

"An award of priority in interference does not necessarily entitle the party in whose favor it is made to a patent."

In *United States Ex Rel. Dwiggins v. Ewing* (1915), 43 App. D.C. 204, the Court said

"It is within the jurisdiction of the Commissioner of Patents to order the dissolution of an interference and the rejection of the claims of one of the parties, if convinced that the issues are barred by public use, and therefore not patentable."

In *Ewing, Commissioner of Patents v. United States Ex Rel. Fowler Car Company* (1917), 244 U.S. 1, the Court said:

"When an applicant for a patent admits that the invention shown in his application was made at a date subsequent to the date upon which another application for the same invention was filed, and by amendment of his application adopts the prior applicant's claims, he thereby concedes the priority of the other's invention, its utility and the sufficiency of the claims. In such a case the Commissioner of Patents cannot be required by mandamus to declare an interference."

In *Kingsland v. Carter Carburetor Corporation* (1948), 83 U.S. App. D.C. 266, the court said:

"Commissioner of Patents has jurisdiction to review on petition a decision of primary examiner on motion to shift the burden of proof in interference proceeding, notwithstanding rule prohibiting appeal from a decision on such motion . . ."

In *Anderson v. Watson*, 103 U.S. App. D.C. 99, 254 F.2d 956, the Court said:

"The question whether the motion for judgment should be passed upon when made during the pendency of the proceedings, or deferred until its final conclusion, is a matter of discretion with the Commissioner, which may not be reviewed by the Courts."

One would not need a second look to see that these cases do not have the slightest relevance to the issues presented in this case. Appellee's concept in citing them seems to be that since the Commissioner of Patents has discretionary power in some things he has such power in all things, regardless of the particular circumstances. This is the oldest fallacy in logic, and is not reasonably expected of an accredited member of the bar in good faith.

In further reply to matter, expressed or implied in appellee's brief, appellant submits:

1. In *Ex Parte Grier*, 1923 C.D. 27; 309 O.G. 223 (cited in 706.04 of Manual of Patent Examining Procedure), Commissioner Robertson said:

"(2) The record in this case shows an inexcusable vacillation on the part of the officials of this office. Claims which were repeatedly allowed were afterwards rejected upon the same patent which was before the Examiner each time they were allowed. * * * Claims that have once been allowed should not ordinarily be considered

unless new art is found or a manifest mistake has been made, and where they have been repeatedly allowed a reversal of position with no new reasons for rejection should be indulged in only where there can be no reasonable doubt."

2. As in the case of his "statement of question presented," appellee misstates the issues before this Court in this case in the "summary of argument" on pages 5 and 6 of his brief. This action is against the Commissioner by appellant for the return of his application unlawfully withdrawn from issue by his approval. Any claim that appellant could have appealed from this approval to the Board of Appeals, a subordinate body, is too absurd to think of. Appellee's argument, whether summary or general, fails to read upon appellant's brief and offer an orderly traversal thereof. Appellee seems to be bent on fantastic claims of "discretionary power" totally foreign to constitutional government.

3. The passage in quotation at the bottom of page 9 of appellee's brief is a distortion of what appellant has said in his brief by failing to complete the sentence running on to the top of page 13 of appellant's brief, reading as follows:

"... but that under the present complex nature of the Patent Office his (Commissioner's) powers and duties are more clearly specified, and that no power ever resided in him in matters complained of herein for acting as he did in this case."

4. Appellee's statement of an "oblique attack on the supervisory authority of the Commissioner of Patents, ..." is an obvious error on appellee's part, whether inadvertent or intentional. Appellant has carefully examined the pages of his brief (11-13) referred to by appellee, and finds only a documentary statement as to the present powers and duties of the Commissioner.

5. Rule 313, Rules of Practice of the United States Patent Office, contemplates that a mistake on the part of the Patent Office is a ground

for withdrawal from issue on petition by the applicant requesting such withdrawal. The rule was not intended to give the Commissioner of Patents unlimited power to withdraw an application from issue on the plea of a mistake on the part of the Patent Office without the consent of applicant except on a new valid reference which applicant after notice has failed to overcome in time for the issue of the patent as scheduled. (Appendix M — 1308 M.P.E.P.) (See also *Schmidt et al. v. Edwin L. Reynolds, Acting Commissioner of Patents*, D.C., D.C., November 6, 1963, Civil Action No. 2600-63, 798 O.G. 7, 8).

6. Appellee denies the jurisdiction of the Court on the plea that 35 U.S.C. 6 gives the Commissioner of Patents a free hand in all matters, regardless of any law governing his conduct in such matters, concerning the Patent Office. Free hand in an individual citizen leads to anarchy; free hand in a government agency leads to despotism, dictatorship, and tyranny, the very name of which is obnoxious to our form of government. Said Section 6 (Appendix B), under which appellee claims unlimited power, places upon him the obligation to "perform all duties required by law . . ." And this is not quite the same as being the law unto himself on the part of appellee. Nor is it required by law that appellee sanction secret cooperation on the part of his office with accused infringers for the sole purpose of defeating appellant's patent.

7. Appellee's interpretation of what was said in the *Moore* case (see pages 7 and 8 of appellee's brief) as to the effect thereof on this case may properly be deemed as a misinterpretation. It may or may not be that "the decision of another tribunal of the Patent Office" was binding upon the Commissioner." That question does not apply to this case. Here we are concerned with the Commissioner's own decision in authorizing the Notice of Allowance "By Direction of the Commissioner" (J.A. 18), thereby approving the decision of the "another tribunal" and making it his own decision and that is certainly binding upon him; and his subsequent capricious change of position by withdrawing the said application

from issue is a proper subject for review by the Court in these proceedings.

8. Generalized remarks in a previous decision, not reading upon issues and circumstances of the particular case, and wholly unnecessary for consideration of the questions presented, are not controlling in a subsequent case with a set of issues and circumstances which were not before the court when it made its decision in the said previous case. This applies to the *Moore* case. Yet in that case, too, the word "shall" (first occurrence) in what is now 35 U.S.C. 131 was interpreted as placing a "duty" on "the Commissioner to cause an examination to be made, . . ." Meaning of the word "shall" was an issue in that case as it is in this case.

9. An administrative agency's decision, unsupported by substantial evidence, is arbitrary and capricious and may be set aside on review. *N.L.R.B. v. Minnesota Min. & Mfg. Co.*, 179 F.2d 323.

10. Requirement that plaintiff exhaust his administrative remedies before applying for judicial relief presupposes effective remedy. *Marsh v. County School Board of Roanoke County, Va.*, C.C. Va., 1962, 305 F.2d 94.

11. Generally party seeking relief against administrative action should first exhaust his administrative remedy, but such doctrine does not apply where claim is advanced on substantial grounds that administrative agency is transcending its legal authority. *Pan Am. World Airways, Inc. v. Boyd*, D.C. D.C., 1962, 207 F. Supp. 152.

12. Courts may prohibit administrative agency action if it is in violation of statutory requirement, if failure of enforcement would defeat apparent Congressional purpose. *Deering Milliken v. Johnston, N. C.* 1961, 295 F.2d 856, confirming 210 F. Supp. 185.

13. Applications for patents are not public documents until they develop into patents, but are secret documents in the office of the

Commissioner. *Utah Radio Products Co. v. Delco Appliance Corp.*, D.C. 1937, 15 F. Supp. 143.

14. Where remedy by appeal is inadequate because of unavoidable delay, the Supreme Court may correct the error by mandamus. *Gaines v. Caldwell*, 148 U.S. 238.

15. When all the conditions prescribed by the statute exist, the Commissioner is bound *prima facie* to issue a patent. *In re Wagner*, Fed. Cas. No. 17,038.

16. The decision of the examiner in the Patent Office on questions of patentability and invention is entitled to great weight and respect. *Lambert v. Dempster Bros.*, D.C. Tenn., 1940, 34 F. Supp. 610.

17. In earlier decisions it was held that the decision of the examiner is not binding upon the commissioner, but where he refuses arbitrarily or unreasonably to issue a patent mandamus will lie to compel him to do so. *Hall v. Patent Commissioner*, 1875, 2 MacArthur, D. C. 90; *Butterworth v. U.S.*, 1844, 5 S. Ct. 25; 112. U.S. 50, *U.S. v. Butterworth*, 1884, 3 Mackay, D. C. 229.

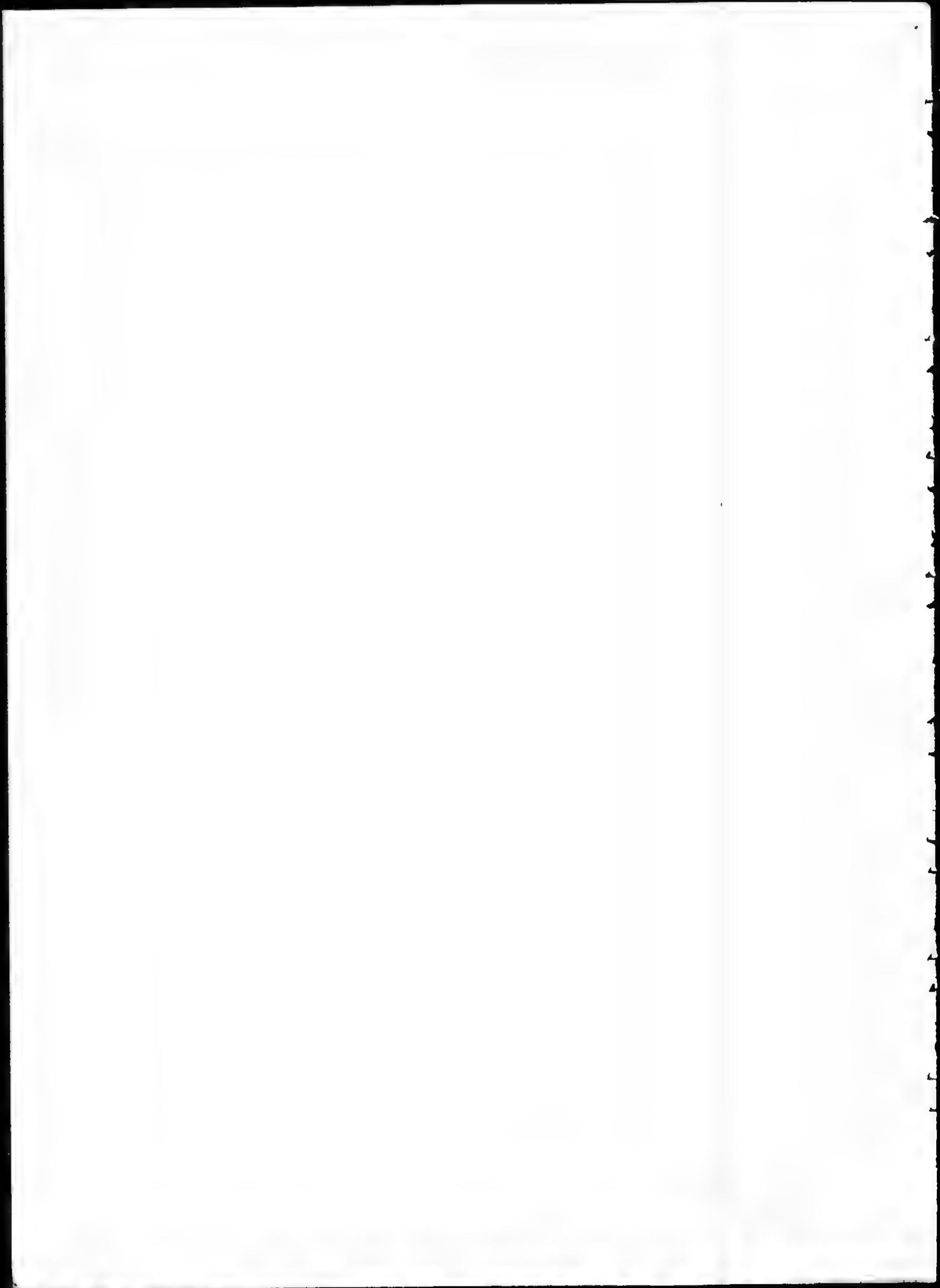
18. In reference to matter stated in the second paragraph of the fifth page of appellee's brief (see also J.A. 17-19), the third paragraph of 35 U.S.C. 112 makes it amply clear that the claims were not intended to be a description of the invention, and that functional expression in claim drafting is no longer tabu within certain limits (which encompass this case). See *In re Joseph D. Fisher*, Judge Rich, C.C.P.A., 314 F.2d 817. See also M.P.E.P. (third edition) 703.06(c).

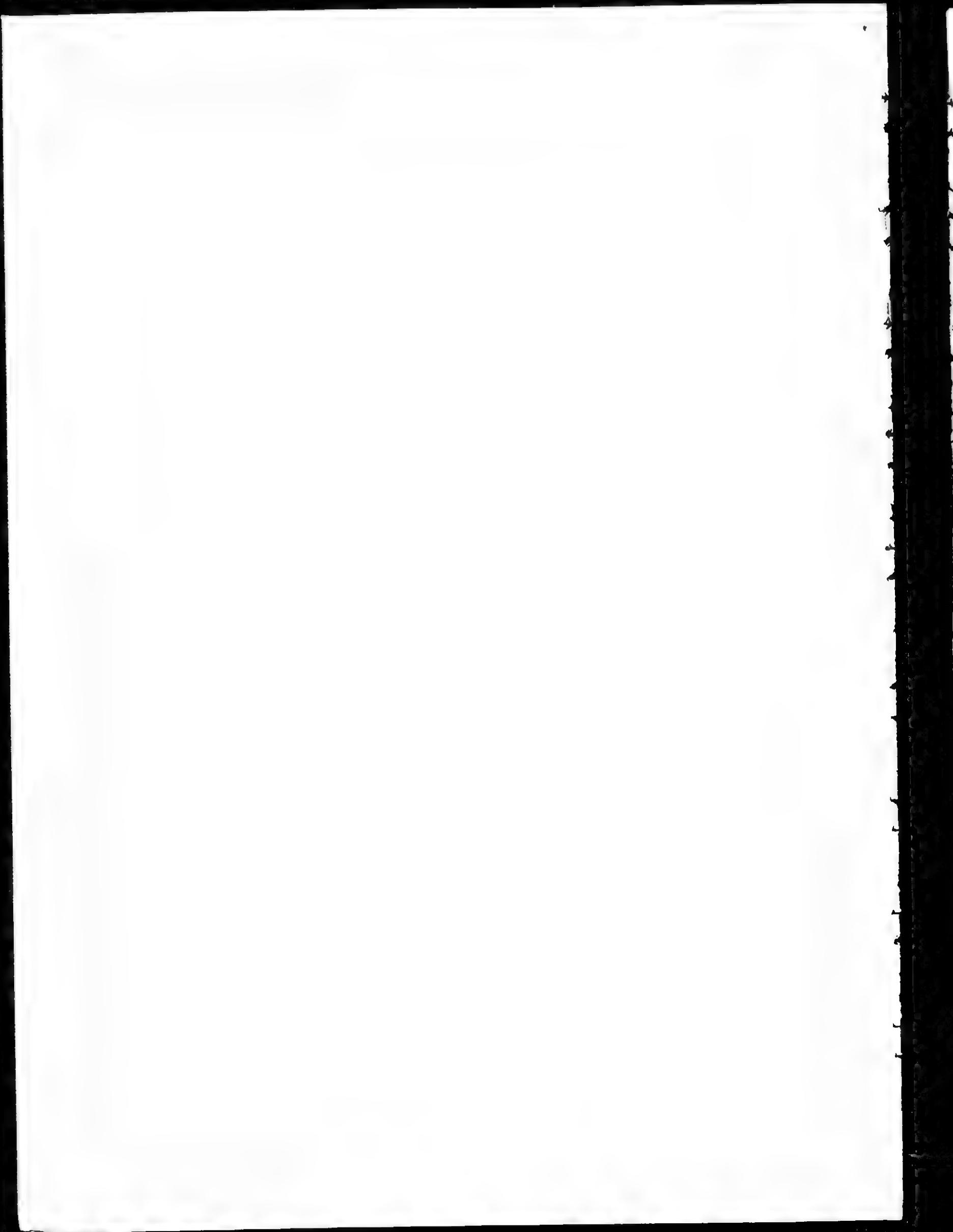
19. It is elementary that any doubt as to the patentability of the claim should be resolved in favor of the applicant. See *Ex parte Hay*, 1909 C.D. 18; 139 O.G. 197; see also M.P.E.P. (third edition) 706.

The decision of the Court below in this case ought to be *REVERSED*.

Respectfully submitted,

SETRAK K. BOYAJIAN
Appellant,
P. O. Box 973
Worcester, Massachusetts
01601





APPELLANT'S PETITION FOR REHEARING

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,717

SETRAK K. BOYAJIAN,

Appellant,

v.

EDWIN L. REYNOLDS,
Acting Commissioner of Patents,

Appellee.

On Appeal from the Judgment of the United States District Court
for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

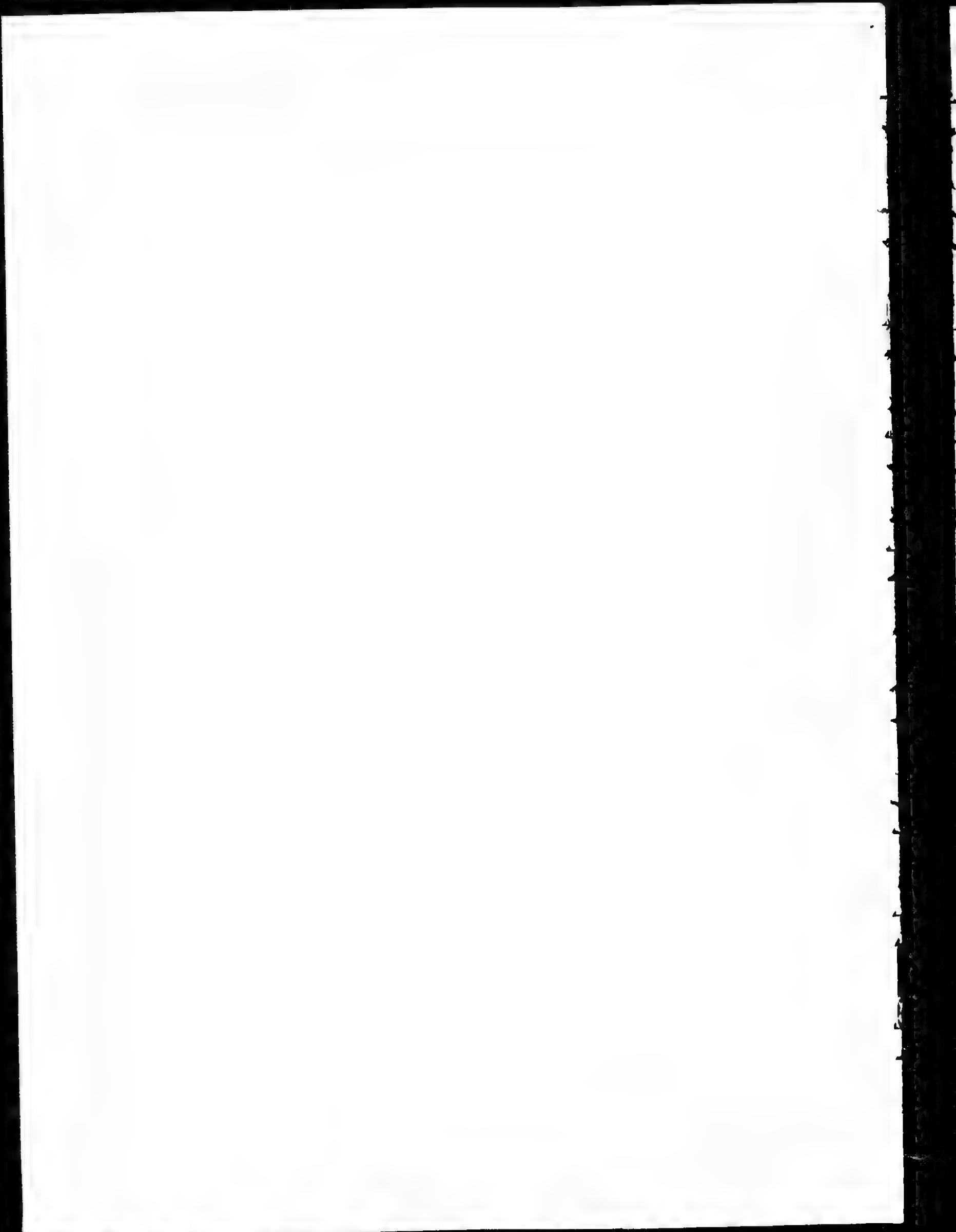
FILED FEB 3 1965

Nathan J. Paulson
CLERK

SETRAK K. BOYAJIAN

P. O. Box 973
Worcester, Massachusetts 01601

Appellant



United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,717

SETRAK K. BOYAJIAN,

Appellant,

v.

EDWIN L. REYNOLDS,
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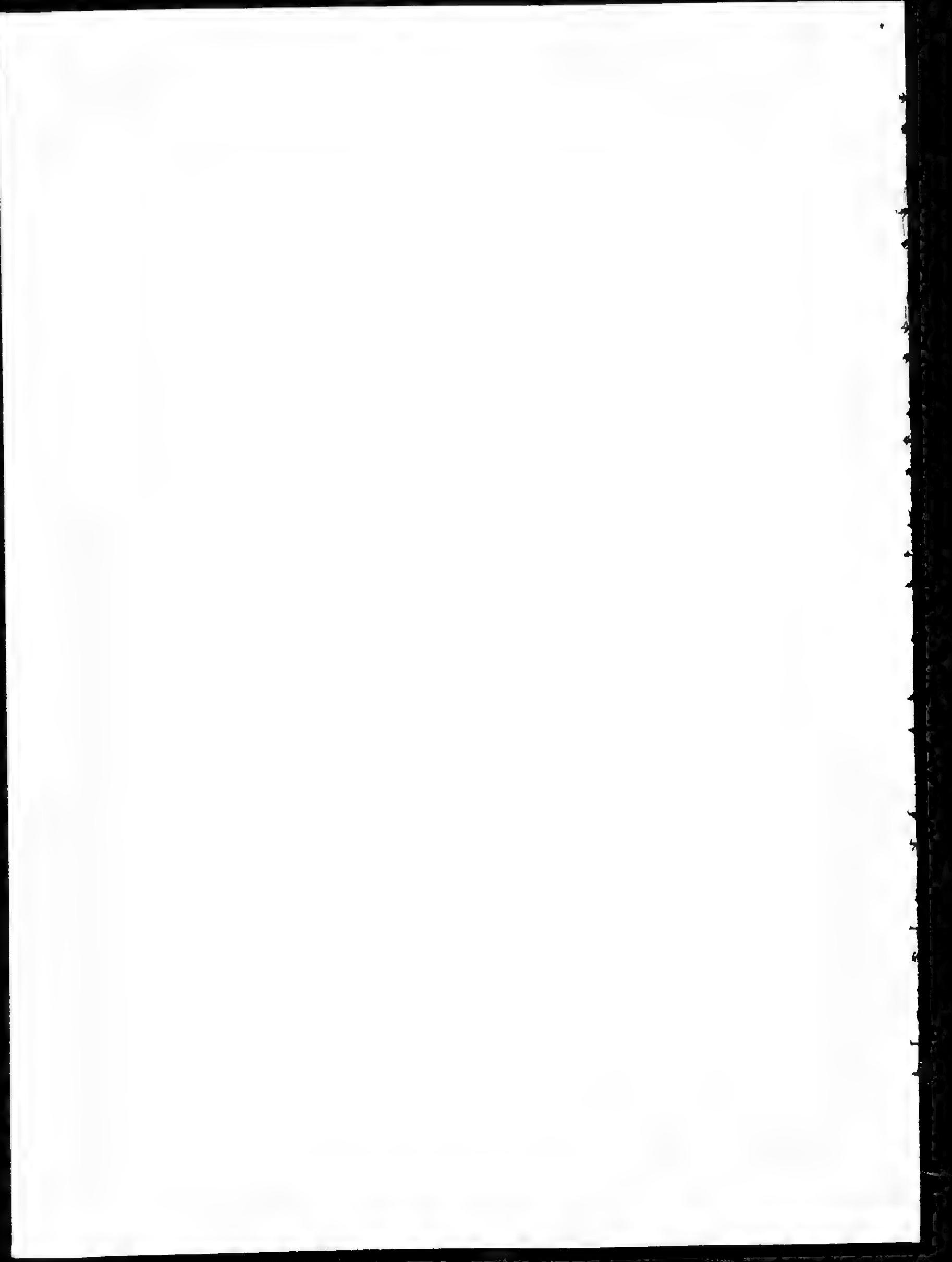
Appellee.

On Appeal from the Judgment of the United States District Court
for the District of Columbia

APPELLANT'S PETITION FOR REHEARING

Appellant above named respectfully petitions this Honorable Court for a rehearing of the appeal in the above-entitled cause, and in support of this petition represents to the Court as follows:

(Appellant reserves his argued position as to each of the points and questions of appeal, but in this petition addresses himself solely

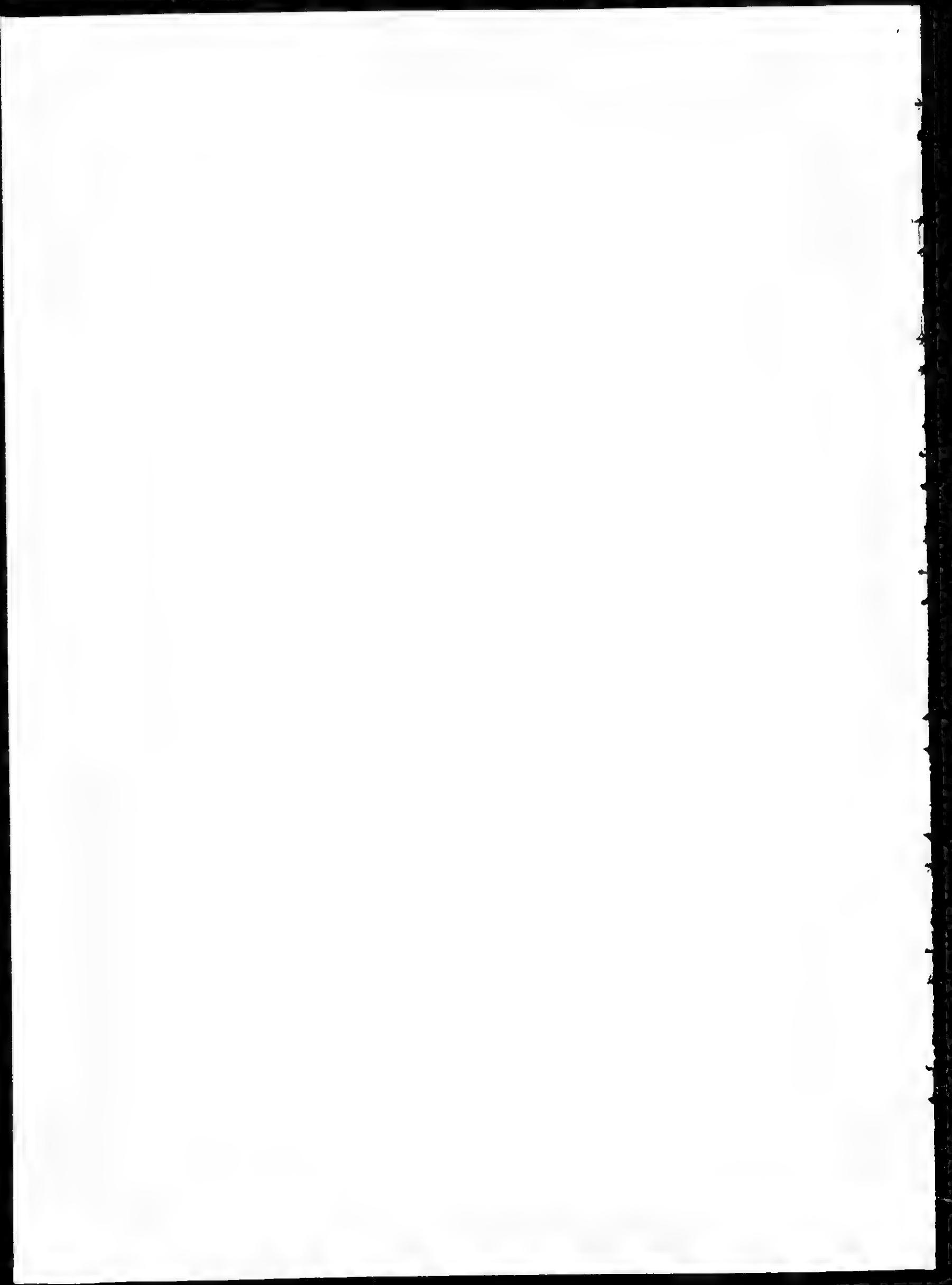


to that feature of the decision wherein he believes this Court may be convinced its result is based upon the application of incorrect legal principles, and upon inapplicable sets of facts, issues, and circumstances, sharply in conflict with the admitted facts in this case, with controlling rules, regulations, and statutes as well as established practice, with applicable decisions of the United States Supreme Court, and with controlling decisions of other United States courts.)

1. This appeal was argued on January 13, 1965 (three months and 13 days after appellant filed his reply brief), and two work-days later, namely, on January 19, 1965, this Court entered its "per curiam" judgment, reading ". . . the order of the District Court appealed from in this cause be, and it is hereby, affirmed. See *Moore v. United States ex rel. Chott*, 40 App. D.C. 591 (1913), *writ of error dismissed*, 237 U.S. 197 (1915)." There was no finding of facts, or opinion, accompanying the judgment and this Honorable Court appears to have based its decision (or refusal to decide) solely on the foregoing citations. Appellant prays this Court that it may be convinced that it erred in so doing.

2. Even where there appears to be no other reasonable explanation, appellant's unqualifiedly high regard and respect for this Court forbids him to entertain any thought that it has made its cursory decision (or refusal to decide) without reading and considering any part of the pleadings submitted by him; but, appellant respectfully submits, even if this were the case, no more alarmingly incorrect decision (or refusal to decide) could have been made than that appearing in the said judgment. Such judgment is, appellant further respectfully submits, contrary to all applicable law and evidence, and fails in every respect to read upon the form and the merits of this case.

3. The facts stated by the court in the *Moore* case (40 App. D.C. 591, *supra*) were copied on pages 10 and 11 of appellant's brief. Such facts were restated somewhat more fully in the same case on writ of error (237 U.S. 197) by the Supreme Court. These are the cases cited

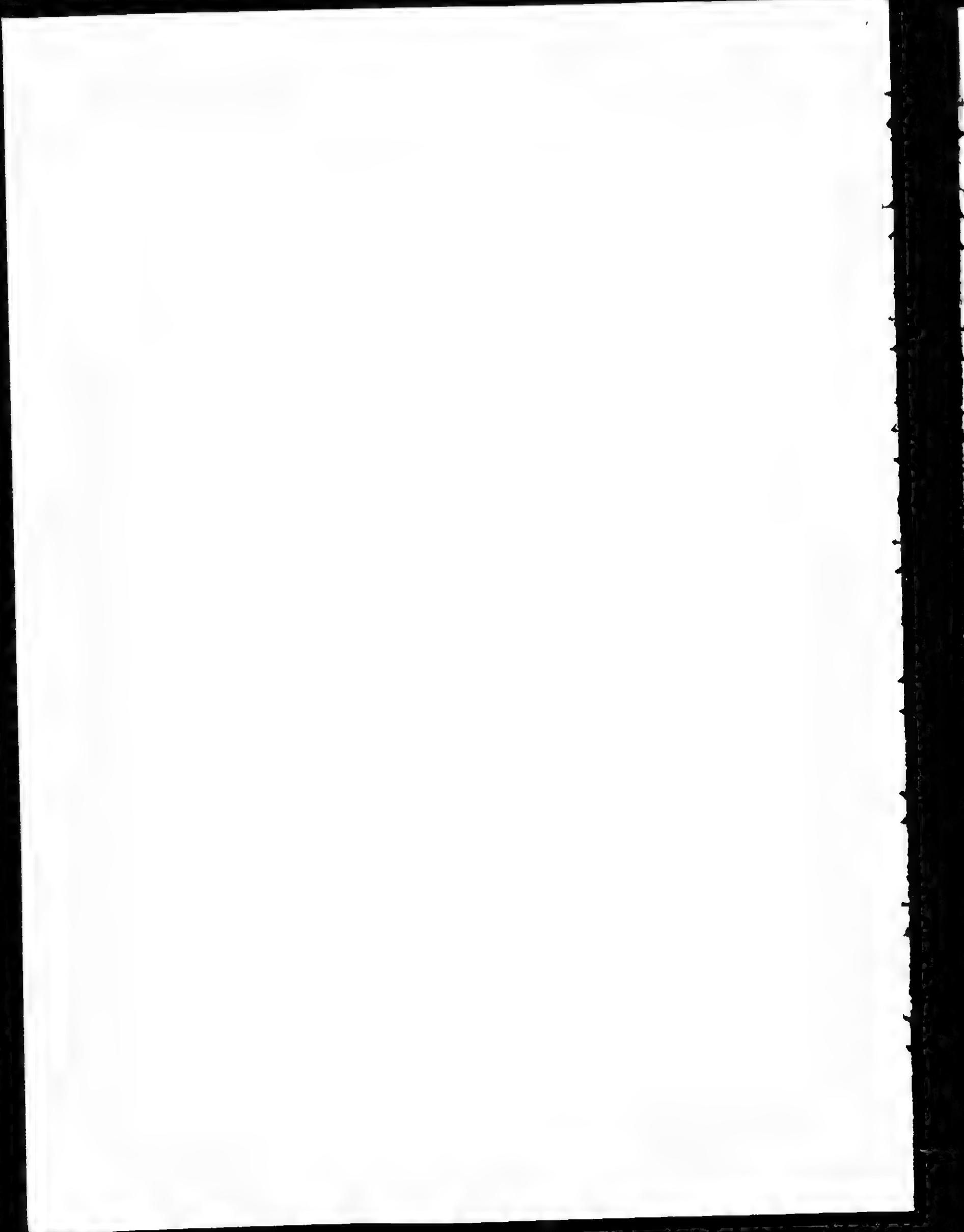


in the judgment. The following is an excerpt from the Supreme Court's opinion in the latter case:

"MR. CHIEF JUSTICE WHITE delivered the opinion of the court.

"A brief statement of the origin and nature of the controversy is essential to an understanding of the questions which we are called upon to decide. The relator applied for a patent. His claim was rejected by the primary examiner. He appealed to the Board of Examiners in Chief, and that body, disagreeing with the primary examiner, reversed his decision and sustained the claims of the patent. By authority of the Commissioner the primary examiner then made a further investigation and directed the attention of the Commissioner to additional patents which it was deemed demonstrated that the invention was not patentable. Thereupon the Commissioner, coinciding with such opinion, approved the action of the primary examiner and decided that the invention was not patentable. The Commissioner, however, did not then formally reject the claim to patent but wrote to the applicant calling attention to the authority of the Commissioner to review the case personally despite the favorable action of the Board of Examiners in Chief and assigning a day when a hearing would be afforded as to the patentability of the invention. The applicant challenged the right of the Commissioner to act in the premises and insisted that as a result of the conclusions of the Board of Examiners in Chief he was entitled to a patent and that it was the plain ministerial duty of the Commissioner to direct it to issue. The Commissioner then filed an opinion insisting upon his authority and pointing out the reasons which caused him to conclude that the invention was not patentable. The opinion concluded with the statement, 'I am clearly of the opinion that the application sets forth nothing upon which a patent can properly be based. The claims are therefore rejected and the patent refused. Appeal from this decision to the Court of Appeals should be taken, if at all, within the time prescribed by the rules of that court.'

"Instead of taking the appeal as thus suggested, the relator commenced this proceeding by mandamus in the Supreme Court of the District to compel the issue of the patent. From a judgment in his favor ordering the mandamus as prayed the Commissioner



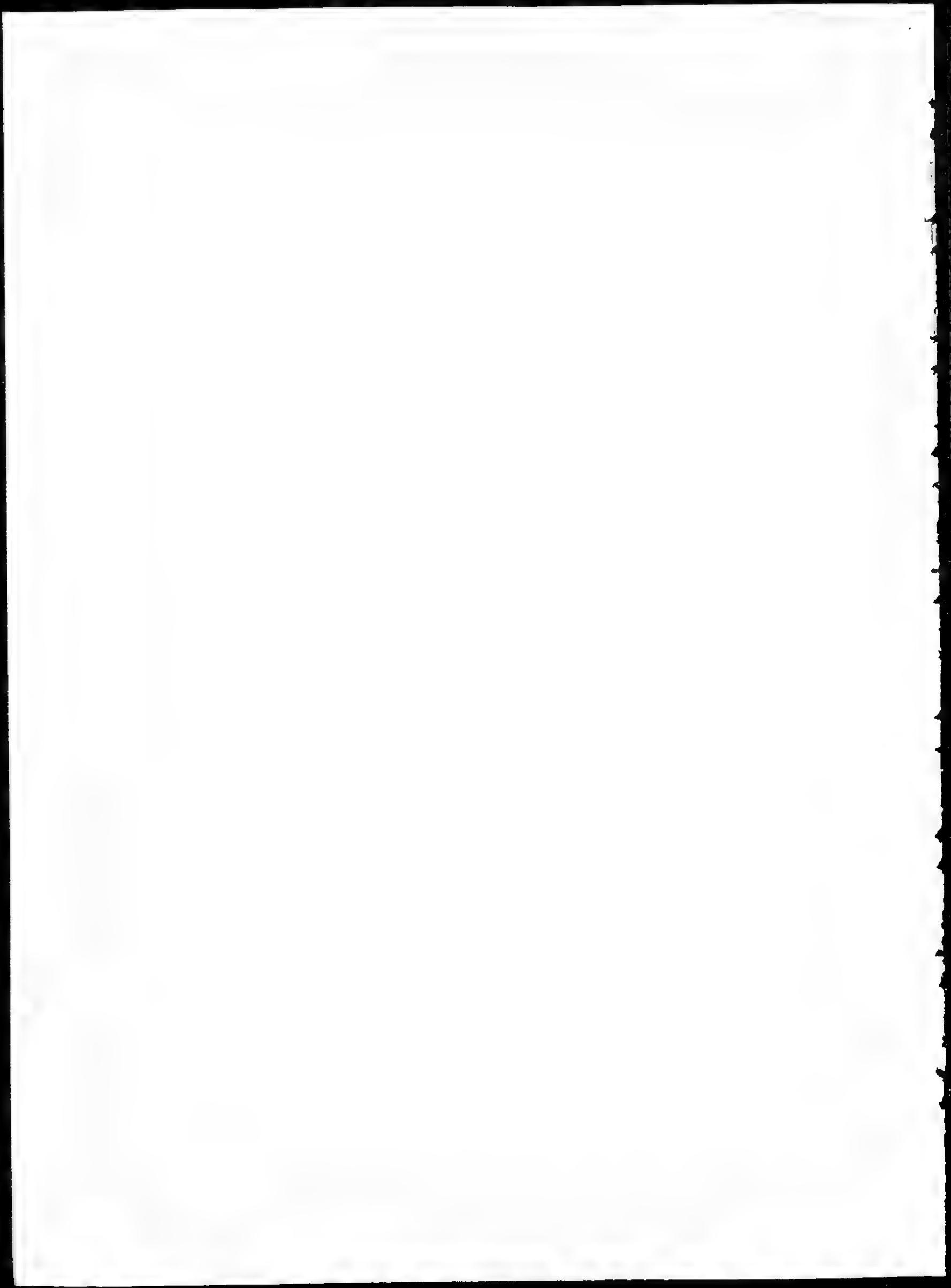
and the primary examiner prosecuted error to the Court of Appeals. That court, concluding that it was without authority to control the Commissioner in the performance of his administrative duties by the writ of mandamus, reversed the action of the trial court, directed the dismissal of the application for mandamus, reserving however the right of the relator to seek by appeal (Rev. Stat. ¶ 4911) the redress of any wrong which it was deemed had been committed by the Commissioner in refusing to direct the issue of the patent, and this writ of error is prosecuted to that judgment. 40 App. D.C. 591."

In conclusion, the Supreme Court said:

". . . , the conclusion is irresistible that the intent and purpose of the act was, while narrowing the imperative jurisdiction, to create an equipoise by extending the voluntary or discretionary exercise of jurisdiction by means of the writ of certiorari, — a purpose which would be wholly frustrated if the contention as to jurisdiction now insisted upon were sustained.

"Dismissed for want of jurisdiction."

From the foregoing quoted paragraphs from the *Moore* case when it was before the Supreme Court on writ of error, it is clear that there are no comparable situations or circumstances between that case and this case. In the *Moore* case, for example, there was no allowance of the claims by the Primary Examiner; there was no Notice of Allowance "By Direction of the Commissioner"; there was no assignment of date and number for the patent to be issued; there was no secret cooperation by the Patent Office with certain accused infringers; there was no arbitrary withdrawal of the application from issue at the instigation of said certain accused infringers and without giving any new reasons or citing any new references and without giving any advance notice to applicant. These are but a few of the distinguishing points that can be listed, but they are quite enough to mark the distinction. Thus the *Moore* case as decided (1913) by the Court of Appeals furnishes no grounds for this Court's said cursory decision (or refusal to decide). Nor does the fact

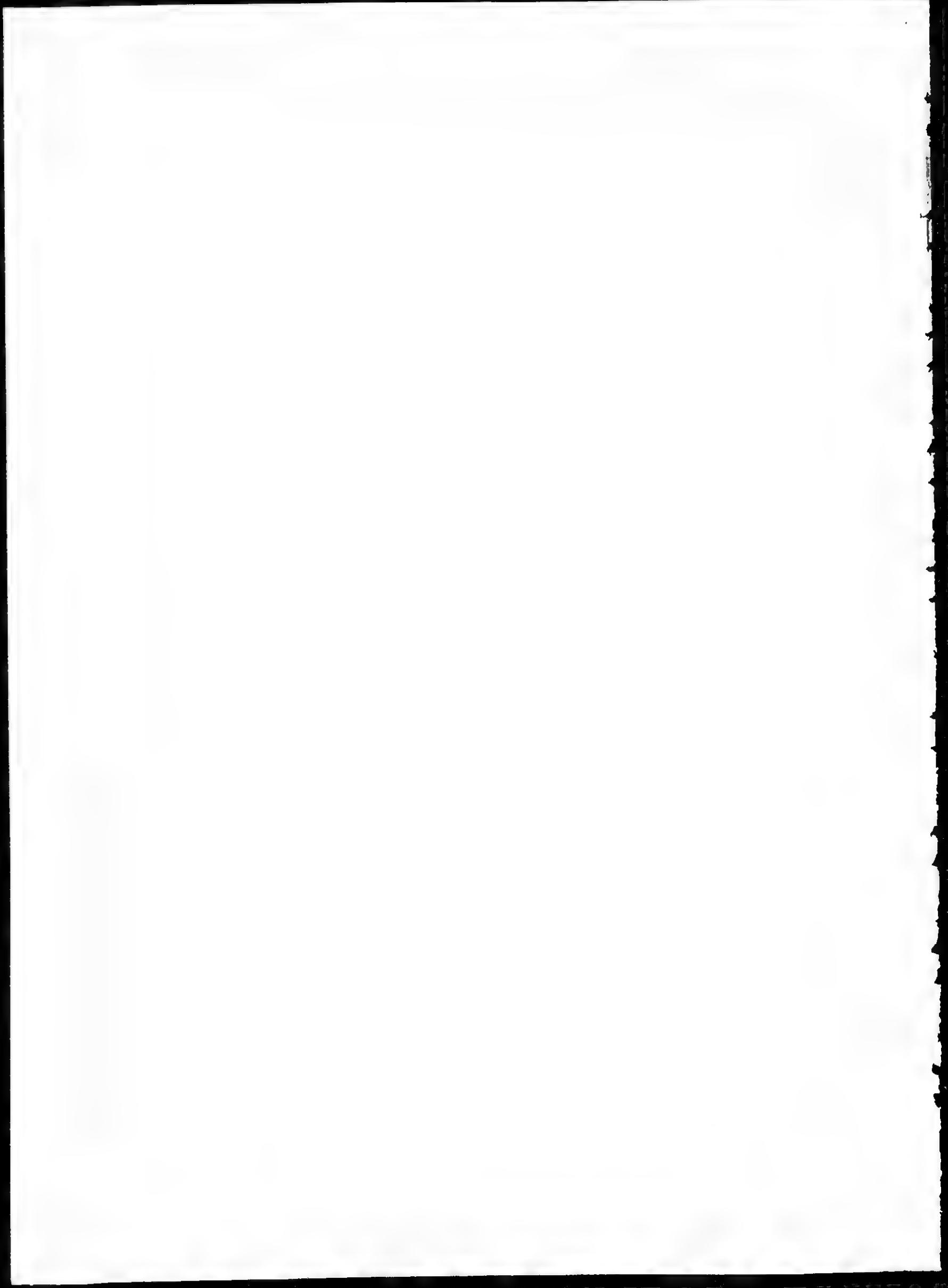


that the writ of error was dismissed furnish such grounds, since such dismissal was purely on jurisdictional issues involving the form of action, and the Supreme Court was quite emphatic on that point by stating "Dismissed for want of jurisdiction," making it clear that the case was not decided on the merits.

4. Moreover, in so far as it is applicable, the *Moore* case (40 App. D.C. 591) supports appellant's cause in this case. Beginning at page 594, the Court in that case said:

"Unquestionably, the decision of Examiners-in-Chief, when favorable to the claimant, is final, unless the Commissioner, in the exercise of his general supervisory power, has authority, upon his own independent investigation, to determine finally whether a patent shall issue. The same would be true of a decision by the Primary Examiner in favor of an applicant. When an application is made for a patent, it is the *duty* of the Commissioner to cause an examination to be made, and 'if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.' The examination here required to be made may or may not lead to an appeal to the Board of Examiners-in-Chief, but whether it does or not, in order to determine that a patent should issue, when it ultimately comes back to the Commissioner after the examination ordered under the statute has been made, he may, upon inspection and review of the examination made pursuant to his order, find that the alleged invention is neither novel nor meritorious. In such a case he would not be bound to violate his official obligation. There is nothing in the law to prevent him from exercising this supervision."

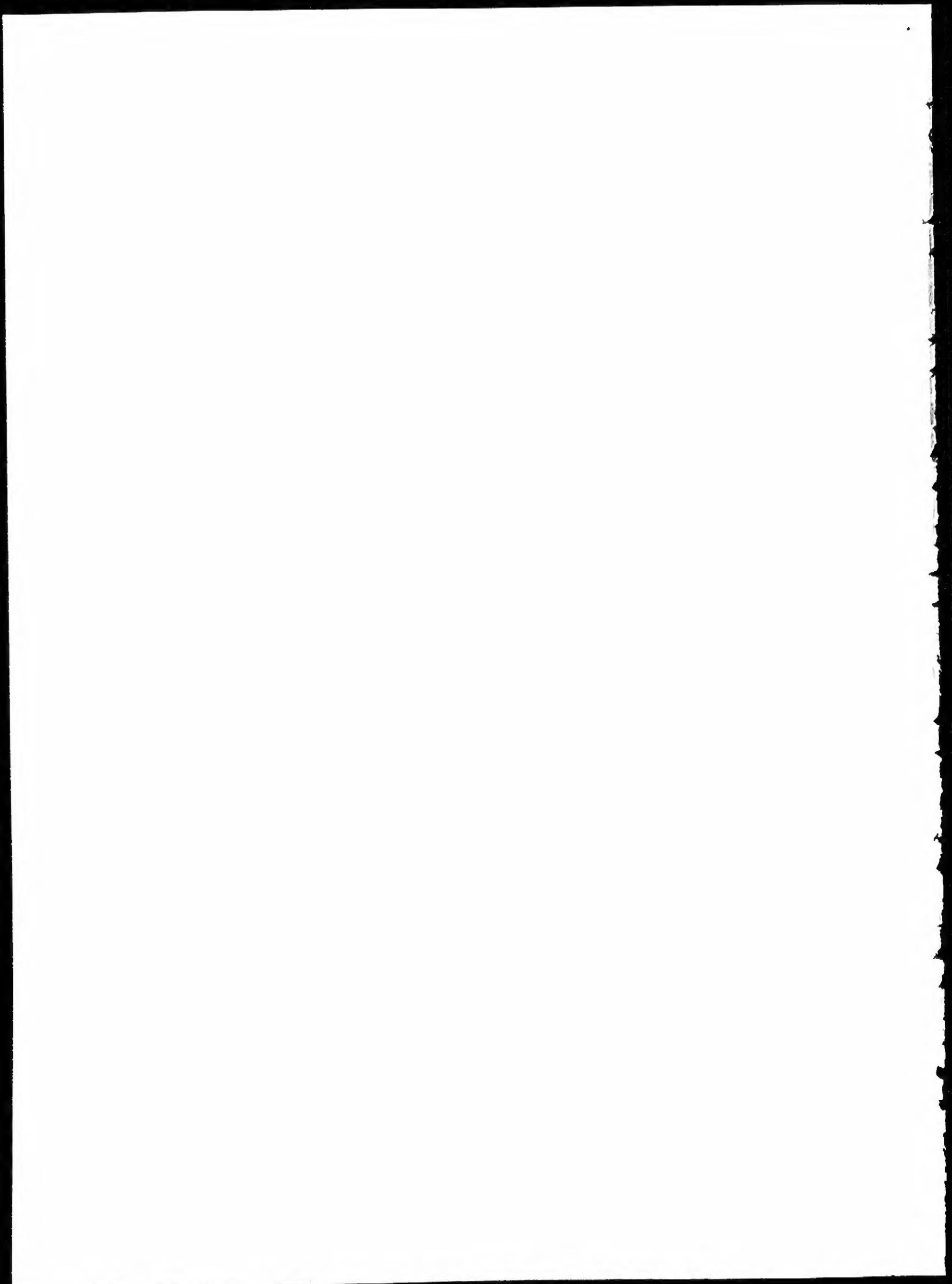
In the present case, "when it ultimately" came "back to the Commissioner after the examination ordered under the statute" had been made, he found "that the alleged invention is" both "novel" and "meritorious," and "that the claimant is justly entitled to a patent under the law," and he "determined *finally*" that "a patent shall issue," and he ordered the patent to issue and served "the claimant" with a "Notice of



Allowance," "By Direction of the Commissioner," and assigned a date and number for the patent to be issued.

But later, by yielding to representations by his Deputy Solicitor who had in turn yielded to pressure, influence, inducement, or what have you, by certain accused infringers, the Acting Commissioner, by capriciously changing position, caused the arbitrary withdrawal of the application from issue without citing any new reference or stating any new reason. Request for the withdrawal had purportedly come from the Primary Examiner. But when the appellant asked him about it, he said that he was only obeying orders; the withdrawal was not his doing. When the Acting Commissioner was asked to explain, he said that the Deputy Solicitor had asked for his approval of the withdrawal. When the latter was asked, he said that he did it because he was "in the middle." That is another expression for conflict of interest. Conflict of interest need not necessarily be pecuniary, and there is no allegation here that it was. The important thing is that no one in the Patent Office has any right to place himself in the middle between the accused infringer and the applicant.

5. Appellant respectfully begs leave to point out to this Honorable Court that this action has been brought, above all, under 5 U.S.C. 1009, wherein the duty placed upon the reviewing court cannot be avoided by any abrupt summary decision (or refusal to decide). In every case where the function of the reviewing court has been specified by the statute, the word "shall" is used. Under paragraph (e) of this statute, it was the duty of the District Court, as well as this Court, to "review the whole record or such portion thereof as may be cited by either party." This is only one of many provisions of Section 1009 with equal force and effect. Upon all issues of fact and law of this case, the Court may be convinced, the said cursory judgment is directly in conflict with Congressional intent as expressed in the said statute.

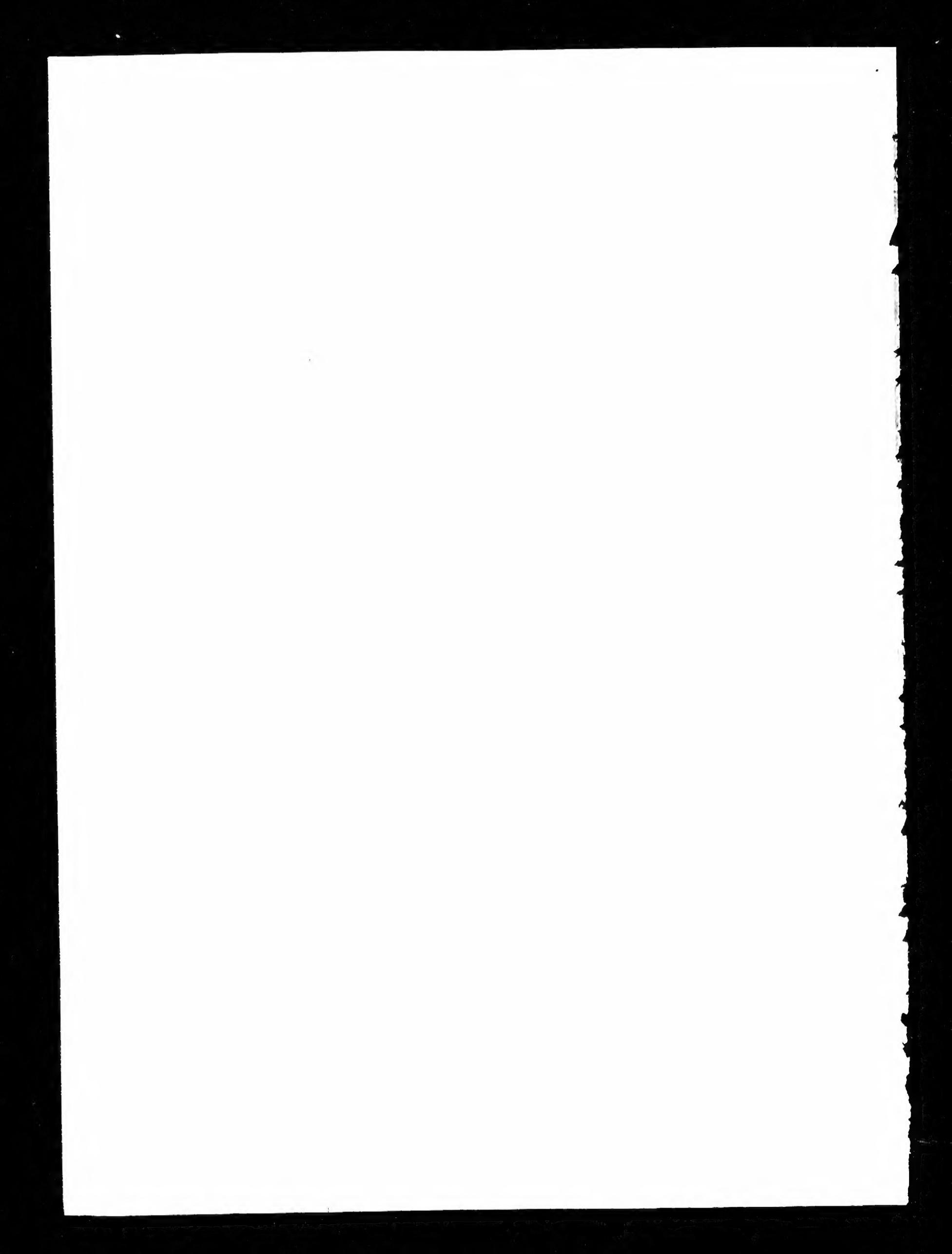


6. Appellant respectfully submits, and the Court may be convinced, that the said judgment does not indicate a dispassionate and disinterested adjudication of all issues of this case, taking "due account of the rule of prejudicial error," but is guided by an undue and undeserved regard for the Patent Office. In *United States v. Morton Salt Company*, 338 U.S. 632, the Supreme Court said:

"Function of judicial review of administrative order is dispassionate and disinterested adjudication, unmixed with any concern as to success of either prosecution or defence."

Appellee has in this case abdicated his statutory duties to said accused infringers, and that is not exactly what Congress had intended for him to do.

WHEREFORE, appellant humbly and respectfully moves this Honorable Court that the entire case may be considered on the merits, as revealed by the record and briefs of both parties, and that a rehearing may be granted as herein petitioned for.



Respectfully submitted,

Signed....Setrak K. Boyajian.....
SETRAK K. BOYAJIAN,
Appellant
P.O. Box 973
Worcester, Mass. 01601

AFFIDAVIT OF APPELLANT

Being duly sworn, I hereby certify that the foregoing petition is presented in good faith and not for delay.

Signed.....Setrak K. Boyajian.....
SETRAK K. BOYAJIAN,
Appellant.

STATE OF MASSACHUSETTS)
) SS.
COUNTY OF MIDDLESEX)

Sworn and subscribed unto before me this 29th day of January,
1965.

Signed....Julia C. Stanis.....
Notary Public.

My commission expires on the.....8th.....day of ...August.....
.....1970.....